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No. 970

In the

Supreme Court of the United States

THE HONORABLE ERNEST GUINN,
United States District Judge,
VICTOR HECHT AND HECHT VALVE COMPANY,
Petitioners,

v.

ACF INDUSTRIES, INCORPORATED,
Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT

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To the Honorable Mr. Justice Warren, Chief Justice, and the Associate Justices of the Supreme Court of the United States:

Victor Hecht and the Hecht Valve Company, Petitioners herein, pray that a Writ of Certiorari issue to review the action and the judgment of the United States Court of Appeals for the Fifth Circuit entered on the 6th day of September, 1967. Petition for rehearing was denied on October 9, 1967.

I.

OPINIONS OF THE COURT BELOW

The opinion of the Court of Appeals is printed in Appendix "A" hereto and has not yet been reported.

II.

JURISDICTION

The judgment of the Court of Appeals was entered on September 6, 1967. Rehearing was denied on October 9, 1967. The jurisdiction of this Court is invoked under Article 28, U.S.C., Sec. 1254 (1).

III.

QUESTIONS PRESENTED

1. Whether the Court of Appeals erred in its opinion holding that even though the Court should discern some grounds for the trial court's decision that the decision here must depend on whether those grounds outweigh the undesirability of setting aside the decision of another district judge and upon such a ground issue a mandamus against the Respondent, The Honorable Ernest Guinn and such a statement of law is clearly erroneous in a case where the Judge who rendered the original opinion assigned the case to Judge Guinn for hearing and action thereon after a new motion was filed.

2. Whether the Court of Appeals erred in holding that in spite of the Title 35, U.S.C.A, 281 and Title 28, Sec. 1400 (a) and (b) giving the Petitioners the right to bring this

suit in the United States District Court for the Western District of Texas that the Court by a stay order could render null and void said statutes and deprive the Petitioners of their rights under its plain and unambiguous terms.

3. Whether the Court erred in holding that the United States District Court of Kansas had jurisdiction even though jurisdiction first attached in a prior suit filed in the United States District Court for the Western District of Texas where the suit was first commenced and jurisdiction was first obtained.

4. Whether the Court of Appeals erred in holding that the Respondents by filing a declaratory judgment act in Kansas after the United States District Court of the Western District of Texas has acquired jurisdiction can stretch the declaratory judgment act to such an extent as to give the Respondents the paramount right to choose the forum for trying out questions of forum and validity.

5. Whether the Court of Appeals erred in holding that a writ of mandamus was available to set aside the order of Judge Guinn setting aside the prior stay order by a writ of mandamus.

6. Whether the Court of Appeals erred in holding that a compulsory counter claim was not required to be filed by the Petitioner in the United States District Court for the Western District of Texas.

7. Whether the Court of Appeals erred in holding that there had not been a change in circumstances since the original decision by Judge Suttle.

8. Whether the Court of Appeals can overrule the opinion of the Supreme Court of the United States in *Hoffman v. Blaski*, 4 L. Ed. 2d 1254, by holding that a stay order could be granted that Judge Suttle might transfer the cause to Kansas even though such transfer could not have been made under applicable statutes with reference to forum non conveniens.

9. Whether the Court of Appeals erred in overruling the many decisions of the Fifth Circuit and of other circuits holding that the Court first acquiring jurisdiction of a controversy should be allowed to proceed without interference of other courts in suits subsequently instituted.

10. Whether the Court of Appeals was correct in holding that in this type of case the Trial Court had no discretionary power to determine whether venue had been established under United States Statutes giving the Court this power.

11. Whether the Court of Appeals can by a writ of mandamus deny the trial court the right of passing upon the plea of forum non conveniens.

12. Whether the Court of Appeals can hold that the plea of forum non conveniens of Respondent ultimately filed after a period of one year had passed and after other remedies proved unavailable had not been waived.

13. Whether the Court of Appeals under any circumstances is justified in issuing the writ of mandamus against the Trial Court who had discretion to determine this cause in a case where the remedy of Respondent was adequate.

14. Whether the extraordinary and harsh writ of mandamus can be issued by the Court of Appeals in order to determine matters such as venue, forum non conveniens that are clearly within the discretionary power of the Trial Court.

15. Whether the Court of Appeals erred in holding that a Trial Court had the power to consider the question of forum non conveniens and to enter a stay order after the jurisdiction of the El Paso Court had attached and a hearing had upon the question of venue and forum non conveniens.

16. Whether a Court of Appeals can give to a Federal Court limitless powers when under Rule 82, F.R.C.P. Federal Courts are courts of limited power except those afforded by statute.

17. Whether the Court of Appeals is justified in violating the plain mandate of the United States Supreme Court with reference to the type of matters here involved as set forth by the Supreme Court in *Kerotest Mfg. Co. v. C-O-Two Co.*, 342 U.S. 180, 72 S. Ct. 219, 96 L. Ed. 200 (1952) and thus substitute their own findings in violation of the rules laid down by the Supreme Court of the United States by virtue of issuance of writ of mandamus against the Honorable Ernest Guinn, United States District Judge in and for the Western District of Texas.

18. Whether the Kansas District Court to whom jurisdiction has been in effect transferred by the entry of the original stay order has venue of a patent action which is a statutory proceeding.

IV.

STATUTES AND CONSTITUTIONAL PROVISIONS INVOLVED

Title 35, U.S.C.A. 281, which provides in part, as follows: "A patentee shall have remedy by civil action by infringement of his patent".

It is further provided in *Title 28, Sec. 1400 (a) and (b)* as follows:

> "(a) The district courts shall have original jurisdiction of any civil action arising under any Act of Congress relating to patents, copyrights and trademarks. Such jurisdiction shall be exclusive of the courts of the states in patent and copyright cases."

The requirements as to venue are set out in Title 28, U.S.C., Sec. 1400 (b) as follows:

> "(b) Any civil action for patent infringement may be brought in the judicial district where the defendant resides, or where the defendant has committed acts of infringement and has a regular and established place of business."

Rule 13 (a), F.R.C.P. dealing with compulsory counterclaims reads as follows:

> "A pleading shall state as a counterclaim any claim which at the time of serving the pleading the pleader has against any opposing party, if it arises out of the transaction or occurrence that is the subject matter of the opposing party's claim and does not require for its adjudication the presence of third parties of whom the court cannot acquire jurisdiction, except that such a claim need not be so stated if at the time the action was commenced the claim was the subject of another pending action. As amended Dec. 27, 1946, effective March 19, 1948."

28 U.S.C.A. Sec. 1404(a):

> §1404. Change of venue
>
> (a) For the convenience of parties and witnesses, in the interest of justice, a district court may transfer any civil action to any other district or division where it might have been brought.

Rule 82, F.R.C.P. entitled "Jurisdiction and Venue Unaffected" reads as follows:

> "These rules shall not be construed to extend or limit the jurisdiction of the United States district courts or the venue of actions therein. As amended Dec. 29, 1948, effective Oct. 20, 1949."

V.

STATEMENT

This litigation involves U. S. patent No. 3,054,594 issued to Victor Hecht for an alleged invention in a carburetor valve, the valve having a resilient or rubber seat. The Hecht Valve Company, Inc. is the exclusive licensee under this patent. ACF Industries, Incorporated is accused of manufacturing and selling a carburetor valve which infringes this patent. Chrysler Corporation and General Motors Corporation are customers of ACF Industries and are accused of infringement by virtue of their use and resale of carburetor valves purchased from ACF Industries.

On June 18, 1964, Victor Hecht filed an action in the United States District Court for the Western District of Texas against ACF Industries and its two customers alleging infringement of patent No. 3,054,594.

Eleven days later, on June 29, 1964, ACF Industries filed an action in the District of Kansas against Victor Hecht and his exclusive licensee, The Hecht Valve Company, Inc.,

seeking a declaratory judgment that patent No. 3,054,594 is invalid and not infringed, and an injunction restraining Victory Hecht and The Hecht Valve Company from bringing or threatening to bring other infringement actions against ACF Industries' customers.

Before answering the complaint in the action pending in the Western District of Texas, ACF Industries filed a Motion to Dismiss For Lack of Venue.

After the case had been pending for nearly one year and after the Respondent became convinced that we could have venue by taking of depositions on the part of petitioners over different sections of Texas a Motion for Forum Non Conveniens was then filed by ACF Industries, the latter motion seeking a stay of that action pending final judgment in the action pending in the District of Kansas or, in the alternative, a transfer of that action to the Eastern District of Missouri under 28 U.S.C., Sec. 1404 (a).

The two motions for hearing as to venue and forum non conveniens was brought before The Honorable Dorwin W. Suttle, United States District Judge for the Western District of Texas. The hearing before Judge Suttle commenced on September 13, 1965, and extended through September 15, 1965. In addition to the affidavits before the Court and the depositions that were introduced in evidence, eight witnesses testified at this hearing. Among the witnesses so testifying were Victor Hecht (Plaintiff below), Clarence E. Keys (one of Hecht's attorneys of record, from Monahans, Texas) and Charles E. Arnold (a pretrial investigator for

Hecht's other attorney of record, John J. Watts of Odessa, Texas).

At the conclusion of the three-day hearing the Court entered a stay order staying the prosecution of the suits against the three defendants in El Paso pending the determination of a declaratory judgment action that was brought after the jurisdiction of the United States District Court of Texas had attached.

It was quite apparent that Judge Suttle attempted to transfer the case under the doctrine of forum non conveniens by the entry of a stay order since a motion for forum non conveniens would not lie under the statute since the suit could not be originally brought in Kansas.

On January 12, 1966, Victor Hecht filed a motion to vacate the Stay Order of September 16, 1965, alleging a change in circumstances since the entry of that order.

On January 25, 1966, Judge Suttle heard this motion and found that there had been no change in circumstances which would cause him to vacate that Stay Order.

On July 29, 1966, The Honorable Ernest Guinn took the oath of office as United States District Judge for the Western District of Texas.

On August 13, 1966, while Judge Suttle was on vacation, Hecht presented an ex parte motion to newly appointed Judge Guinn, which motion sought to set aside the Stay Order entered almost one year earlier on September 16, 1965, by Judge Suttle. Judge Guinn did not grant this motion, but he did issue an Order to Show Cause why Hecht's motion should not be granted.

In the meantime the Courts had entered into an assignment of the docket agreement under which Judge Guinn would hear the civil cases pending before the El Paso Court which would, of course, include the case at bar and Judge Suttle would take up the criminal cases for the Western District of Texas.

Thereafter, on November 21, 1966, a hearing on the Order to Show Cause was held before Judge Guinn. No witnesses testified nor were any affidavits or depositions introduced in evidence at this hearing.

The record is quite voluminous on oral argument and both sides conceded that depositions had been taken all over the United States at great expense to the parties that could be used in either the trial in Texas or the trial in Kansas.

The argument of counsel will show that it was in effect stipulated that the discovery had been completed and that these depositions could be used regardless of whether the case was tried in Kansas or in Texas.

Judge Guinn stated four times during the arguments that he would consult with Judge Suttle concerning the matter prior to entering his final decision.

On December 16, 1966, Judge Guinn entered an order without opinion summarily setting aside Judge Suttle's Stay Order of September 16, 1965, overruling ACF Industries' *Forum Non Conveniens* Motion and overruling ACF Industries' Motion to Dismiss for Lack of Venue.

The reasons given for Judge Guinn's vacation of the stay order were in effect that he felt the Western District of

Texas was the only court that had jurisdiction since suit was first commenced there and that it was the duty of the court to rule; that the Motion for Forum Non Conveniens due to the fact that depositions had been taken all over the United States made it about as convenient to try the case in one court as in another insofar as the issue of forum non conveniens as to this patent infringement action was concerned and after full argument of all counsel, including counsel for Chrysler and General Motors, the Court set aside Judge Suttle's stay order September 16, 1965, overruled ACF's forum non conveniens motion and overruled ACF's motion for lack of venue.

This was the first time that the motion for forum non conveniens had been ruled on by any court or the motion to dismiss for lack of venue since Judge Suttle reserved his decision on these two motions pending the action of the Kansas Court in the declaratory judgment action.

Judge Guinn exercised his discretion in refusing to certify the question under 28 U.S.C.A. Sec. 1292(b) so as to permit an interlocutory appeal.

Even though it has been contended throughout by the petitioner ACF that there was a difference of opinion of the two judges of the same Court as to the proper place of trial there is nowhere any evidence that after the change of conditions had taken place, to-wit, the taking of depositions over many areas of the United States that could be read by both parties where the case was tried the judges were in difference of opinion as to the correctness of Judge Guinn's order and certainly under any theory the

plea had been waived by the respondent. Likewise, the question of determining whether there had been a change of circumstances since Judge Suttle entered the stay order was a power clearly within Judge Guinn's discretion. Judge Suttle could not by way of a stay order transfer this case to a court in which suit could not originally have been brought, Title 28 Sec. 1404(a) controls venue under these circumstances where the suit had been first filed in Texas.

If this Decision stands we might as well abolish our lower courts and get quick findings on venue and transfer and Jurisdiction by the quick use of the Writ of Mandamus in the Appellate Court.

The Circuit Court of Appeals *assumed that this amounted to the action of one court setting aside the judgment of another.*

ACF thereafter filed a Petition for Writ of Mandamus which was granted by the Fifth Circuit. The issue of whether the Fifth Circuit was correct in issuing this mandamus against Judge Guinn under the above circumstances is the prime issue before this Honorable Court.

VI.

REASONS FOR GRANTING WRIT

1. The decision of the Court of Appeals is not in accord with applicable decisions of this the Supreme Court of the United States.

The holdings complained of in the preceding statement and the questions raised are in direct conflict with all statutory patent law and all rules and cases dealing with venue

and the doctrine of forum non conveniens and the applicable federal statutes heretofore quoted that are involved herein.

It would seem that the Supreme Court of the United States would expect litigants in the lower courts to follow their decisions involving these kind of matters and hence, it is imperative in order for this court to enforce its own decision in *Hoffman v. Blaski*, 4 L. Ed. 2d 1254 and *Kerotest Mfg. Co. v. C-O-Two Co.*; 342 U.S. 180, 72 S. Ct. 219, 96 L. Ed. 200 (1952) for this court to grant the writ of certiorari and hold that the 5th Circuit erred in issuing the writ of mandamus.

In addition thereto the writ of mandamus insofar as we have been able to find has never been issued in this kind of case where the appeal or remedy at law was adequate on behalf of Respondent.

The Fifth Circuit has apparently decided this case not only on distorted conception of the law but they have also decided the case on facts that are contrary to the allegations made by Petitioners in their petition for writ of mandamus. We would like to point this out as follows.

The Petitioner ACF admitted before the Fifth Circuit that on August 13, 1966, while Judge Suttle was on vacation Hecht presented an exparte motion to the newly appointed Judge Guinn, which motion sought to set aside the stay order entered almost one year earlier by Judge Suttle (R. 651-62). The Petitioner admits on page 35 in the Petition for Mandamus that Judge Guinn did not grant this motion, but he did issue on August 13, 1966, an order to

show cause why Hecht's motion should not be granted (R. 663).

The petitioner ACF before the Fifth Circuit alleged in its Petition for Mandamus on page 35, as follows: "When Judge Suttle returned from vacation, *he resumed his role in the Texas action and considered Hecht's motion to set aside the Stay Order* of September 16, 1965 (R. 664, 678). "Petitioner further admits on page 35 of its Petition for Writ of Mandamus as follows: "On October 7, 1966, an order was filed in the Texas court whereby the Civil and Criminal Dockets in the El Paso Division of that Court were divided between Judge Guinn and Judge Suttle (R. 679). The Civil Docket was assigned to Judge Guinn and the Criminal Docket was assigned to Judge Suttle. This order also contained the following provisions:

> 'It is provided, however, that nothing herein shall be construed as prohibiting the Judges *from assisting one another with such foregoing assignment in any manner they may see fit.* The disqualification of any Judge in any case assigned to him shall automatically assign such case to the one not disqualified immediately upon certification of disqualification by such Judge.'" *This order clearly placed the vacation of this stay order within Judge Guinn's discretion.*

The Petitioner ACF before the Fifth Circuit further admits on page 37 of its Petition for Mandamus as follows: "On four separate occasions during the course of this hearing, Judge Guinn expressed his intention to have a full discussion with Judge Suttle before ruling on Hecht's motion to vacate Judge Suttle's Stay Order of September 16, 1965 (R. 698, 706, 716-7 and 750)."

We would call the Court's attention to the fact that the hearing before Judge Guinn was not held until November 16, 1966 after Petitioner has admitted as heretofore set out that Judge Suttle *considered this very motion and after Judge Suttle's failure to overrule same, Judge Suttle then assigned same to Judge Guinn for hearing.*

Petitioner Hecht respectfully submits that there is no basis under the above record for holding that one judge has overruled another, since Judge Suttle under the admissions of Petitioner considered the motion to set aside said stay order of September 16, 1965 and thought it of sufficient merit that he assigned same to Judge Guinn under their division of the docket agreement for rehearing.

The opinion of the Fifth Circuit to the effect that Judge Guinn has overruled Judge Suttle as to this Motion for Rehearing is not based on anything except the argument set forth in the Petitioner, ACF's Application before that Court and the inferences that have been drawn by the Petitioner, ACF.

It is clear that the Fifth Circuit has drawn an improper inference from the facts in taking the view that Judge Guinn has overruled Judge Suttle without the consent and agreement of Judge Suttle.

We are therefore confronted with not only an erroneous holding of law in a number of vital respects to the jurisdiction of the courts and a clear failure to follow the mandates of this Court but the Fifth Circuit has acted upon this case in the assumption of facts not supported by the record in the case.

The Petitioner Hecht has contended throughout that the Federal Court first acquiring jurisdiction of the subject matter is entitled to proceed to final judgment on all issues. There can be no real dispute but that the United States District Court for the Western District of Texas first acquired jurisdiction of this cause.

The Fifth Circuit who was reversed by this Honorable Court in the decision, *Hoffman v. Blaski*, 4 L. Ed. 2d 1254, has attempted to dodge the impact of the Blaski opinion by quoting a footnote on page 7 of its opinion as follows, and this Honorable Court has determined this case adversely to Respondent, ACF's contention.

> "Since a transfer is not requested, we need not determine if the Texas suit might have been brought in the Kansas court. See *Hoffman* v. Blaski, (1960), 363 U.S. 335."

This is really ingenious. The Fifth Circuit now tries to get as the law the very law with reference to interest of justice and convenience of the parties that they attempted to declare in *Blaski* supra. This Court repudiates this doctrine in *Blaski* and the Fifth Circuit now tries to come in by the back door by virtue *of a stay order. Stay orders cannot circumvent the statutes relative to venue and the convenient forum as was clearly ruled upon by this Court in Blaski, supra.*

It is quite apparent that the Fifth Circuit has not only overruled the *Blaski and Kerotest*, supra cases, but have denied to Petitioners here the protection of the United States Statutes and rules heretofore quoted.

As a matter of fact if the decision of the Fifth Circuit stands in this case the Federal Courts will become courts of limitless jurisdiction and what the Fifth Circuit tried to do in *Blaski* will become the law and the Federal statutes with reference to venue and transfer will be completely nullified.

It is quite evident that there are no provisions under the statutory law giving jurisdiction to the United States District Court of Kansas to try the patent infringement case involved herein and hence, even though that court might be a court of general jurisdiction and patent jurisdiction as to some cases it was not under *Blaski and Kerotest*, supra, as to the petitioners herein.

The cases relied upon by the Respondent ACF, petitioner in the Court below, are not in point since they have been overruled by the *Blaski case*, supra, by this Court, 4 L. Ed. 1254. In this case this Court said as follows:

> "Blaski and others, residents of Illinois, brought this patent infringement action in the United States District Court for the Northern District of Texas against one Howell and a Texas corporation controlled by him, alleging that the defendants are residents of, and maintain their only place of business in the City of Dallas in the Northern District of Texas, where they are infringing respondents' patents. After being served with process and filing their answer, the defendants moved, under §1404(a), to transfer the action to the United States District Court for the Northern District of Illinois. 363 U.S. 337. Respondents objected to the transfer on the ground that, inasmuch as the defendants did not reside, maintain a place of business, or infringe the patents in and could not have been served with process in, the Illinois district, the courts of that

district lacked venue over the action and ability to command jurisdiction over the defendants; *that therefore that district was not a forum in which the respondents had a right to bring the action, and, hence, the court was without power to transfer it to that district.*"

The Court further said:

> "*Petitioners' 'thesis' and sole claim is that §1404(a), being remedial, Ex parte Collett,* 337 U.S. 55, 71, 93 L. Ed. 1207, 1216, 69 S. Ct. 944, 959, 10 A.L.R. 2d 921, should be broadly *construed and, when so construed, the phrase 'where it might have been brought' should be held to relate not only to the time of the bringing of the action, but also to the time of the transfer;* and that *'if at such time the transferee forum has the power to adjudicate the issues of the action,* it is a forum in which the action *might then* have been brought.'" (Emphasis added)

The Court further said:

> "We do not agree. We do not think the §1404 (a) phrase *'where it might have been brought' can be interpreted to mean,* as petitioners' theory would require, 'where it may not be rebrought, with defendants' consent.' This Court has said, in a different context, that §1404 (a) is 'unambiguous, direct (and) clear,' Ex parte Collett, 337 U.S., at 58, and that 'the unequivocal words of §1404 (a) and the legislative history * * * establish that Congress indeed meant what it said.' United States v. National City Lines, Inc., 337 U.S. 78, 84, 93 L. Ed. 1226, 1230, 69 S. Ct. 955, 959. Like the Seventh Circuit, 260 F. 2d, at 322, we think the dissenting opinion of Judges Hastie and McLaughlin in Paramount Pictures, Inc. v. Rodney, 186 F. 2d 111 (C.A. 3d Cir.), correctly answered this contention:
>
> > *'But we do not see how the conduct of a defendant after suit has been instituted can add to the formus where "it might have been brought."* In the normal meaning of words this language of §1404(a) directs the attention of the judge who

is considering a transfer to the situation which existed when suit was instituted.'

"It is not to be doubted that the transferee courts, like every other District Court, had jurisdiction to entertain actions of the character involved, but it obvious that they *did not acquire jurisdiction over these particular actions when they were brought in the transferor courts.* The transferee courts could have acquired jurisdiction over these actions *only if properly brought in those courts,* or if validly transferred thereto under § 1404 (a). Of course, venue, like jurisdiction over the person, may be waived. A defendant, properly served with process by a court having subject matter jurisdiction, waives venue by failing seasonably to assert it, or even simply by making default. Commercial Casualty Ins. Co. v. Consolidated Stone Co., 278 U.S. 177, 179, 180, 73 L. Ed. 252, 254, 49 S. Ct. 98; Neirbo Co. v. Bethleham Shipbuilding Corp. 308 U.S. 165, 84 L. Ed. 167, 60 S. Ct. 153, 128 A.L.R. 1437. *But the power of a District Court under § 1404 (a) to transfer an action to another district is made to depend not upon the wish or waiver of the defendant, but, rather, upon whether the transferee district was one in which the action 'might have been brought' by the plaintiff.*"

The Court further said:

"In any event, the conflict between the Circuits is now resolved, and what happened here *will not happen again.*"

These important decisions by the Supreme Court speak for themselves so as to show that the cases relied upon by the Respondent are not in point and even if in point, have been overruled and that Petitioner Hecht is entitled to certiorari.

The law dealing with this fact situation was further made quite clear by a Circuit Court construing the holding of

this Court *Kerotest Mfg. Co. v. C-O-Two Co.*, 342 U.S. 180, 72 S. Ct. 219, 96 L. Ed. 200 (1952) in *Sunstrand Corp. v. American Brake Shoe Company*, 315 F. 2d 273, in which the Court in discussing the Kerotest case said:

> "The United States Supreme Court in Kerotest Mfg. Co. v. C-O-Two Co., 342 U.S. 180, 72 S. Ct. 219, 96 L. Ed. 200 (1952), laid down guidelines for the lower courts in handling the complex multiple suit, multiple party, and forum non conveniens problems that arise in patent actions. While the Supreme Court therein established a broad area of discretion in the District Courts to enable them to properly regulate the course of complicated litigation in these area, nowhere in the opinion can we find authority for the action of the Illinois District Court in the instant case.

In Kerotest:

> "In Kerotest the patent owner filed an action for infringement against a customer of the manufacturer alleged to be infringing. This action was started in Illinois. By amendment the manufacturer was added as a defendant, but prior to the amendment the manufacturer had instituted a Declaratory Judgments Act suit against the patentee in Delaware. The District Court in Delaware enjoined the patentee from proceeding in the Illinois suit against the manufacturer and refused to stay the Delaware action. The Court of Appeals for the Third Circuit reversed and the Supreme Court affirmed.
>
> "While the fact situations in Kerotest and the instant case are not exactly parallel, *it is to be noted that in Kerotest, the final disposition permitted the first filed suit to proceed.* Moreover, in each of the cases, referred to by the Court in its footnote (fn. 3 at 184, 72 S. Ct. at 221) *it was the prosecution of a subsequently filed suit that was sought to be enjoined or stayed.*

As to the problem which faced the trial judge in the case at bar, we believe the Supreme Court's language in Kerotest is significant:

> *'The manufacturer who is charged with infringing a patent cannot stretch the Federal Declaratory Judgments Act to give him a paramount right to choose the forum for trying out questions of infringement and validity.* He is given an equal start in the race to the courthouse, not a headstart. *If he is forehanded subsequent suits against him* by the patentee can within the trial court's discretion be enjoined pending determination of the declaratory judgment suit, and a judgment in his favor bars suits against his customers. If he is anticipated, the court's discretion is broad enough to protect him from harassment of his customers. If the patentee's suit against a customer is brought in a district where the manufacturer cannot be joined as a defendant, the manufacturer may be permitted simultaneously to prosecute a declaratory action against the patentee elsewhere. And if the manufacturer is joined as an unwilling defendant in a forum non conveniens, he has available upon an appropriate showing the relief provided by Sec. 1404 (a) of the Judiciary Code. 62 Stat. 869, 937, 28 U.S.C. Sec. 1404 (a).'

"The Supreme Court recognized the right of a litigant to initially choose his forum—even where this involves a 'race to the courthouse.' American Brake Shoe had a statutory right for which it sought vindication in the Maryland court. Its right was separate and independent from that against the alleged infringing manufacturer, and such right, sanctioned by statute, ought not be interfered with except for compelling reasons. 35 U.S.C. Sections 271, 281; Birdsell v. Shaliol, 112 U.S. 485, 488, 5 S. Ct. 244, 28 L. Ed. 768 (1884); Minnesota Mining & Mfg. Co. v. Polychrome Corp., 267 F. 2d 772 (7th Cir. 1959)."

Without further prolonging this Petition for Writ of Certiorari we refer this Honorable Court to the reading of that case so as to show that the petitioners herein were entitled to bring this suit in the Court where jurisdiction could be obtained over General Motors and Chrysler as well.

The above two cases clearly in point with the fact situation here and being *by this Honorable Court should not have been repudiated by the Fifth Circuit* whose duty it is to strictly observe, adhere to and follow the law as laid down by this the highest Court in our land and hence certiorari without hearing should be granted.

An additional case holding that mandamus was not a proper remedy in this type situation by this Court which the 5th Circuit has violated is the case of Bankers Life & Casualty Company v. Honorable John W. Holland, 98 L. Ed. 107, 346 U.S. 379, and is another compelling reason why writ of certiorari should be granted in this case under the decisions of this Court in the Holland case supra.

This court said:

> "The petitioner, an Illinois corporation, brought a treble damage action in the District Court for the Southern District of Florida, alleging a conspiracy to injure its business in violation of the anti-trust acts, and naming as defendants, in addition to residents of the Southern District of Florida the insurance commissioner of Georgia, who was personally served in the Northern District of Florida, but resided in Georgia.
>
> "In order to meet the requirements of § 4 of the Clayton Act (15 U.S.C. § 15), which allows suit in any district court in the district in which the defendant 'resides or is found or has an agent,' petitioner pro-

ceeded on the theory that co-conspirators are each others' agents, and that the commissioner therefore was 'found' and had 'agents' in the district of suit. The trial court, however, after holding that it had jurisdiction of the action and of the commissioner, held that venue was not properly laid, and, pursuant to 28 U.S.C. § 1406 (a), ordered the action as to the commissioner served and transferred to the Northern District of Georgia. Petitioner then sought a writ of mandamus from the Court of Appeals to compel the trial judge to vacate the order of severance and transfer. The court of Appeals dismissed the petition on the ground that mandamus was not an appropriate remedy.

"Five members of the Supreme Court, in an opinion by Clark, J., affirmed on the ground that the writ of mandamus did not lie to correct a merely erroneous decision of an inferior court, *as long as it did not involve a clear abuse of discretion or usurpation of judicial power.*"

Where we ask was the abuse of discretion? Where petitioner asks was the usurpation of judicial power? Petitioners submit that abuse and usurpation of judicial power occurs when Federal statutes are nullified and when Judge Suttle refused to act and entered a stay order contrary to the Blaski and Kerotest opinions and the Federal Rules and Statutes. The Fifth Circuit opinion in this case amounts to judicial abdication in which the Circuit Court refuses to follow their duty of following the decisions of the Supreme Court construing the statutes involved herein. This is such a serious matter that certiorari without further hearing save the action of this Court should be granted.

The writ of mandamus does not lie in this type of case where the trial court had the discretionary power to determine whether venue had been established and whether the

Plea of Forum Non Conveniens had been waived. Hence, the Fifth Circuit erred in holding contra.

The converse of what the 5th Circuit did is the true rule of law. A writ should issue against a trial court such as Judge Suttle who issues a stay order when it is the court's duty to *rule on said pleas under the established statutes and rules of civil* procedure, supra, not to mention the common law rules *concerning the duty of a court to rule and to act in conformity with Federal Statutes, Rules and decisions.*

It is quite apparent that trial judges no longer have any discretion as to these matters if the Circuit Court opinion in this case as to causes that have been assigned by the original trial judge, to the court against which mandamus is sought stands. Insofar as Trial Courts and litigants are concerned, appeals will be thus abolished and mandamus becomes the remedy and the Appellate Court will make findings of fact by means of the application for writ of mandamus and thus invade the legislative intent of Congress and the Supreme Court of the United States decisions pertaining to jurisdiction and mandamus, thus destroying the right of trial judges as well as the right of litigants to proceed to trial without first having the appellate court determine whether jurisdiction, venue and forum non conveniens applies or whether a stay order is appropriate.

This appears to be an invasion of all of the well settled rules of this and other courts and represents such a departure from time honored and established precedents of

this and other courts that a petition for certiorari should be granted by this Honorable Court as prayed for herein.

Briefly stated, the opinion in this case may be summarized as saying that the Fifth Circuit for the first time in the jurisprudence of America has held that the Court which first acquired jurisdiction *should surrender its rights by virtue of a stay order to a Court in which the Petitioners brought suit for declaratory judgment eleven days thereafter and to which under Title 28—140(a) governing the doctrine of forum non conveniens this cause could not be transferred because it could not have originally have been brought in Kansas.*

This was done upon the theory that a *stay order could be used as a substitute for the statutory remedy provided under the terms of Rule 1404(a)* and *insofar as we know, no other court in the United States has ever so held.*

Certainly, Justice Cardozo said nothing in the *Landis case*, 299 U.S. 248, that would give the Fifth Circuit this power. *Landis*, supra, *held that it had to be an emergency creating a judicial scandal before this remedy should be used.* The Landis case dealt with stay orders not issued is violation of Federal Rules, Federal Statutes and Supreme Court decisions.

For this and many other reasons, this case is such a departure from elementary and well settled law, as well as the decisions of this Court and the *Supreme Court of the United States that it is a case calling for the immediate granting of this writ of ceriorari before the legal world be-*

comes completely bewildered and before Hecht loses his day in court.

The Fifth Circuit in *Ex Parte Blaski*, 245 F. 2d 737, in which the able, eminent and conscientious Judge Rives, author of the opinion in the case at bar participated, held that the Court could take such matters of convenience into consideration in cases where it would be *in the interest of justice to so do but the Supreme Court as heretofore stated reversed this holding in 4 L. Ed. 2d 1254, holding that Congress meant what it said and that the courts could not bring it in any other district court than Congress had provided.*

The doctrine of forum non conveniens, it is respectfully submitted, cannot be applied to a stay order *so as to do indirectly what the Supreme Court of the United States held in Blaski, supra, cannot be done directly upon the theory that it would be wise for the purposes of the administration of justice and thus render the Federal statutes set out hereinabove mere wastepaper and make of Congress a stooge for the Courts and this is particularly true where the highest Court in our land has laid down clear decisions upholding the rights claimed by petitioners herein and hence certiorari without hearing should be granted.*

As a matter of fact, if this case is permitted to stand, *the legal world will be thrown into a state of judicial chaos, overburdened district judges (and this court will take judicial notice there are many) will stay the proceedings in many cases wherein they have jurisdiction to a court in a foreign jurisdiction where many defendants will file motions*

for declaratory judgment in such foreign jurisdictions so as to impose undue delay, expense and inconvenience to plaintiffs.

In this respect let the Court note that probably the greatest amount of infringement involved in this case was committed in the Western District of Texas where the petitioner does business in such a way that there was a definite legal ground for *giving respondents the right to select their forum at a place where A.C.F. the other two defendants could be tried.*

In this case the record reflects that *there has been a change of circumstances* in that this case is now ripe for trial as to all defendants and the mere fact that plaintiff in a patent suit has to try the issue of validity first and thereafter have a trial on the issue of damages does not justify the Court of Appeals in saying that the stay order was valid and thus have piece-meal litigation in two states with different circuits and declaratory judgments in foreign states can mess up the calendars of the federal district courts of the United States for many years to come, as well as the rights of litigants under *sacred and time honored statutes.*

Certainly the Court of Appeals should not claim that under the *Landis case,* supra, that *the interest of justice is so acute that this kind of practice should now be inaugurated for the first time.*

The cases relied upon by the Court of Appeals in its opinion do not so hold.

In the *Blaski case* the Supreme Court of the United States said "*this would not occur again,*" *but the Judge that said that did not realize the ingenuity of lawyers and judges.*

Any other holding would cause *Rule 1404 (a)* and the statutes quoted, *Title 28, 1400 (a) and (b)* to be mere nullities subject to the whims and caprices of our courts. *Our statutes and Congress would become meaningless and no lawyer or litigant would know where to proceed.*

The Supreme Court of the United States in Blaski and Kerotest, supra, has said plainly this cannot be done, the Supreme Court so stated *with great clarity and logic.* We therefore think that if these cases are now to be overruled this should be done by this Court and not by a lower court.

We, therefore, respectfully submit that this Court should hastily undo this dangerous opinion insofar as the rights of litigants particularly petitioner herein and insofar as the protection and enforcement of statutes and rules of civil procedure are concerned to litigants that are to follow are concerned.

Judical encroachment upon the legislative branch of our Government should be *avoided by* the correction of this opinion and by the granting of this petition for certiorari without further hearing save this application and the action of this court thereon. A learned United States District Judge has been abused and the rights of petitioners have been flagrantly violated by this opinion. Justice insofar as petitioners herein are concerned has been too long delayed without cause or justification.

The opinion of the Court of Appeals as written is a clear *invasion of the constitutional rights of the litigants in this case and of the powers delegated to Congress under the Constitution.*

In *Tokio Marine & Fire Ins. Co. v. Aetna Cas. & Surety Co.*, 322 F. 2d 113, cited in the opinion of the Circuit Court of Appeals, the now Chief Justice of the 5th Circuit Court of Appeals, Justice John R. Brown, quoted Justice Story as follows: "It is for the public interest and policy to make an end to litigation * * * so that "* * * suits may not be immortal, while men are mortal,". In that case Justice Brown permitted the Texas Court in which *the litigation had first begun to proceed.*

That is what we are asking for here, rather than a piecemeal trial in Kansas and a suit against two other defendants and ACF in Texas. See *Kerotest Mfg. Co. v. C-O-Two*, 96 L. Ed. 200; *Sunstrand Corporation v. American Brake Shoe Co.*, 315 F. 2d 273.

We base our conclusion that this is the first time in American Jurisprudence that this has been declared to be the law in part upon the quotation from the *Sunstrand case*, supra, as follows:

> "While the fact situations in Kerotest and the instant case are not exactly parallel, *it is to be noted that in Kerotest, the final disposition permitted the first filed suit to proceed.* Moreover, in each of the cases, referred to by the Court in its footnote (fn. 3 at 184, 72 S. Ct. at 211) *it was the prosecution of a subsequently filed suit that we sought to be enjoined or stayed.*"

We respectfully submit that it is therefore quite apparent that this writ of mandamus should be dissolved by the

granting of this petition for certiorari without further hearing save the action of this Honorable Court.

The right of the petitioners here to bring this suit in the El Paso District where complete relief could be had against all defendants is well demonstrated by the following cases and Rule 13(a).

In the case of *Link-Belt Co. v. Dorr Co.*, 15 Fed. Supp. 663, the action taken by Judge Guinn is approved:

> "Congress has provided that patent owners may bring suit for infringement in the District Courts of the United States 'in the district of which the defendant is an inhabitant, or in any district in which the defendant * * * shall have committed acts of infringement and have a regular and established place of business.' Jud. Code § 48, 28 U.S.C.A. § 109. *The present motion seeks to deprive Dorr of this statutory right.* It is clear that the Federal Declaratory Judgments Act (Jud. Code § 274d, 28 U.S.C.A. § 400) does not deprive a patent owner of his right to sue in the district of which a defendant is an inhabitant."

Under Rule 13-A of the Federal Rules of Civil Procedure Judge Guinn entered the only order that could be entered in this case. The order of Judge Suttle was and is void.

Judge Guinn had jurisdiction to enter this order protecting the jurisdiction of his Court since the claim involved herein involves the same transaction or occurrence that is the subject matter of the defendants' claim and motion for summary judgment pending in the United States District Court at Wichita, Kansas.

Rule 13(a), Federal Rules of Civil Procedure, provides as follows:

> "(a) Compulsory Counter claims. A pleading shall state as a counterclaim any claim which at the time

> of serving the pleading the pleader has against any opposing party, if it arises out of the transaction or occurrence that is the subject matter of the opposing party's claim and does not require for its adjudication the presence of third parties of whom the court cannot acquire jurisdiction. But the pleader need not state the claim if (1) at the time the action was commenced the claim was the subject of another pending action, or (2) the opposing party brought suit upon his claim by attachment or other process by which the court did not acquire jurisdiction to render a personal judgment on that claim, and the pleader is not stating any counterclaim under this Rule 13."

The factors to be considered under Rule 13(a) in determining whether the defendants' claim against the plaintiff is a compulsory counterclaim are:

(1) Does it arise out of the transaction or occurrence that is the subject matter of the defendants' claim?

(2) Does it require for its adjudication the presence of third parties of whom this court cannot acquire jurisdiction?

(3) Was Hecht's action pending when the defendants' action in Kansas was commenced?

Considering these factors, *Rule 3, Federal Rules of Civil Procedure,* provides:

> "A civil action is commenced by filing a complaint with the Court."

The filing of the complaint commences the action under this rule and for the purposes of *Rule 13(a), Federal Rules of Civil Procedure. 1 Barron & Holtzoff, Federal Practice,* 630-631.

Under the express wording of Rule 13(a), it is the time of the commencement of defendant's action and not the date of service of process that governs the filing of a compulsory counterclaim. An argument that the date of service is the controlling date under Rule 13(a) was rejected in *Coates v. Ellis*, 61 A. 2d 28, 30 (Mun. Ct. App. D.C. 1948), where the court said:

> "As we understand appellant's argument he does not question that his claim would ordinarily be the subject of a compulsory counterclaim; but he says that Rule 13 (a) does not apply to this situation because it provides 'that such a claim need not be so stated if at the time the action was commenced the claim was the subject of another pending action.' And he argues that the District Court action though filed March 4, 1948, had not been 'commenced' when he filed this suit in the Municipal Court eight days later, because process in the District Court had not been served upon him and that by the time such process was served he had already filed his Municipal Court action and such action was then 'the subject of a pending action' and hence not a compulsory counterclaim in the District Court action.
>
> "The argument must fail. Rule 13 (a) itself says that such counterclaim shall be compulsory unless it was the subject of a pending action *at the time the original action was commenced.* It is clear beyond question that the District Court action has been 'commenced' eight days before this action was filed in the Municipal Court. It is quite well settled that an action is 'commenced' by the filing of the complaint."

In *United States v. Szerlip*, 169 F. Supp. 529, 530 (E.D.N.Y. 1959), the court stated:

> "* * * The defendant is in error as to the time when the action was commenced because he is of the opinion that the action was not commenced until a copy of the

> complaint was served upon him on April 4, 1955. In fact the action was commenced on March 14, 1955 by the filing of the complaint in the office of the Clerk of this Court. Rule 3, Federal Rules of Civil Procedure, 28, U.S.C.A."

With respect to factor (2) above, it is clear that the adjudication of Hecht's claim against the defendants requires only the presence of the defendants, all of whom are subject to the jurisdiction of this Court.

With respect to factor (1) above, the defendants asserted claim against Hecht arises out of the transaction or occurrence that is the subject matter of Hecht's claim.

In Moore's Manual, Federal Practice and Procedure, 706 (1962), it is stated:

> "Courts should give the phrase 'transaction or occurrence that is the subject matter' of the suit a broad realistic interpretation in the interest of avoiding a multiplicity of suits. Subject to the exceptions, any claim that is logically related to another claim that is being sued on is properly the basis for a compulsory counterclaim. This works no hardship upon parties or counsel, since although in the unusual case it may not be clear that the claim is compulsory, subdivision (b) permits it to be pleaded, and hence there is no penalty for such action. Furthermore, subdivision (f) protects against oversight inadvertence, or excusable neglect."

The court, in *Williams v. Robbins*, 1 F.R.D. 211, 213 (D.C. 1940), in discussing the term "transaction or occurrence" stated:

> "* * * It seems apt to say that the words 'transaction' and 'occurrence' as used in Rule 13(a) include the facts and circumstances out of which a cause of action may arise; *Scarborough v. Smith*, 18 Kan. 399. The words 'transaction' and 'occurrence' probably mean

> whatever may be done by one person which affects another's rights and out of which a cause of action may arise. Whether the subject matter of opposing claims is the same requires an examination into the basic facts underlying each of them. A familiar test may be applied by inquiring whether the same evidence will support or refute the opposing claims."

In *Moore v. New York Cotton Exchange*, 270 U.S. 593, 610 (1926), the court stated a test of "logical relationship" for determining whether claims arise out of the same transaction or occurrence under Rule 13(a), saying:

> "Transaction is a word of flexible meaning. It may comprehend a series of many occurrences, depending not so much upon the immediateness of their connection as upon their logical relationship."

The Court of Appeals for the Third Circuit applied this test in *Great Lakes Rubber Corp. v. Herbert Cooper Co. Inc.*, 286 F. 2d 631, 634 (3rd Cir. 1961):

> "The phrase 'logical relationship' is given meaning by the purpose of the rule which it was designed to implement. Thus, a counterclaim is logically related to the opposing party's claim where separate trials on each of their respective claims would involve a substantial duplication of effort and time by the parties and the courts. *Where multiple claims involve many of the same factual issues, or the same factual and legal issues, or where they are offshoots of the same basic controversy between the parties,* fairness and considerations of convenience and of economy require that the counterclaimant be permitted to maintain his cause of action. *Indeed the doctrine of res judicata compels the counterclaimant to assert his claim in the same suit for it would be barred if asserted separately, subsequently.*"

In discussing the liberal view given the word "transaction" in *Moore v. New York Cotton Exchange*, supra, the court in *Princess Fair Blouse, Inc. v. Viking Sprinkler Co.*, 186 F. Supp. 1, 4 (M.D.M.C. 1960), noted that this view is firmly established:

> "This liberal view is now well established. It is the test that has been determined the 'one compelling test of compulsoriness.' *Rosenthall v. Fowler*, D.C.N.Y. 1952, 12 F.R.D. 388, 391. It is generally accepted that the term 'transaction or occurrence' io to be given a liberal construction, and is not to be used in any narrow or restricted sense, and the counterclaim is compulsory if there is any logical relation between the plaintiff's claim and the counterclaim. 1A Barron and Holtzoff, Federal Practice and Procedure, Sec. 394. * * * Courts should give the phrase "transaction or occurrence that is the subject matter" of the suit a broad realistic interpretation in the interest of avoiding a multiplicity of suits.' 3 Moore's Federal Practice, Sec. 13.13 (2d Ed. 1948). *Courts, having acquired jurisdiction of a cause for any purpose, should dispose of the entire controversy and not leave any part of it unsettled. Arizona Lead Mines v. Sullivan Mining Co.*, D.C. Idaho 1943, 3 F.R.D. 135. *'The adjustment of defendant's action rather than by independent suit is favored and encouraged by the law. That practice serves to avoid circuity of action, inconvenience, expense, consumption of the courts' time, and injustice.' Chicago & N.W. Ry. Co. v. Lindell*, 1929, 281 U.S. 14, 50 S. Ct. 200, 201, 74 L. Ed. 670."

Moore's Federal Practice, Vol. 3, page 38, together with the Advisory Committee Note of 1946, and the footnote thereto, seem to settle this question as follows:

> "Suppose P had sued A in the federal court, and that thereafter, but before answering, A commenced

suit against P in either a state or federal court. Under the Rule as originally drafted, it was doubtful whether or not A was required to assert his claim as a compulsory counterclaim in P's federal action. The 1946 amendment to subdivision (a) eliminated the ambiguity and made it clear that the exception applies only if at the time the federal action was commenced A's claim was the subject of a pending action. *The possibility of a contrary construction was regarded as undesirable since it would permit a party having a claim which would be the subject of a compulsory counterclaim to avoid stating it as such by bringing an independent action in another court after the commencement of the federal action but before serving his pleading in the original federal action.*"

"If A commences action in a federal court before P institutes his proposed federal action, multiple litigation should not be countenanced. Rule 13 applies in all federal courts and P should counterclaim in A's action. If P, in addition to counterclaiming, institutes a federal action A should be able to have it abated, certainly where both actions are pending in the same federal court, *and at least have P's action stayed if brought in another federal court.*"

The Circuit Court of Appeals for the 5th Circuit and all other courts have long followed the general rule that the court first acquiring the jurisdiction of a controversy should be allowed to proceed without interference from other courts under suits subsequently instituted. *Carbide & Carbon Chemicals Corporation v. United States Industrial Chemicals, Inc.*, 140 F. 2d 47 (4th Cir. 1944); *In Re Georgia Power Co.*, 89 F. 2d 218 (5th Cir., 1937).

Petitioners would show that the circumstances had changed since the original entry of the order, since depositions had been taken all over the United States which could be used at the time of trial and since it is pointed out in the original brief of the Petitioners here respondents in the lower court that the case was ready for trial in Pecos in May, 1967, on the merits and the Court had no discretion under *Landis*, supra, except to permit Judge Guinn to act as suggested by Justice Cardozo in the *Landis case*, 299 U.S. 458. We quote from *Landis*, supra, as follows:

> "To bring about a fitting correspondence between rulings and realities, there must be a new appraisal of the facts by the court whose function it is to exercise discretion, and an appraisal in the light of the situation existing and developed at the time of the hearing." 299 U.S. at p. 258.

This is particularly true where Mr. Pugsley, attorney for General Motors, admitted in his argument before Judge Guinn that General Motors might be held liable as an original infringer by virtue of the Rochester valve. (R. 719). Petitioners have the right to dispose of this case in one trial, in one forum as to all Defendants including the Respondent A.C.F.

WHEREFORE, your Petitioner respectfully prays this Honorable Court to grant the Petition for Writ of Certiorari to the end that on review the Circuit Court may be directed to reverse its judgment and that this Court should affirm

the Judgment of the United States District Court in and for the Western District of Texas, El Paso Division.

Respectfully submitted,

JOHN J. WATTS,
P. O. Box 1031,
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and

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By: Gerald S. Sugg
Attorneys for Petitioners.

CERTIFICATE OF SERVICE

A true and correct copy of the foregoing Petition for Certiorari has been furnished counsel for Respondents: Mr. William J. Barnes and Mr. John O. Tramontine, 227 Park Avenue, New York, New York; Mr. John Grambling, Third Floor, El Paso Natural Gas Company Building, El Paso, Texas; and Mr. Mikel Stout, 600 Fourth National Bank Building, Wichita, Kansas, by placing a copy of same in the United States Mail, postage paid, Certified Mail, Return Receipt Requested on this 27 day of December, A.D. 1967.

Jerald S. Sugg

APPENDIX A

In the

UNITED STATES COURT OF APPEALS

For the Fifth Circuit

No. 24613

ACF INDUSTRIES, INCORPORATED,

Petitioner,

versus

THE HONORABLE ERNEST GUINN,
United States District Judge,

Respondent.

(September 6, 1967).

ON PETITION FOR WRIT OF MANDAMUS

Before RIVES and DYER, Circuit Judges, and JOHNSON, District Judge.

RIVES, Circuit Judge: ACF Industries, Incorporated, petitions this Court for a writ of mandamus directing the Honorable Ernest Guinn, United States District Judge for the Western District of Texas, to vacate an order by him entered in Civil Action No. 2657, *Victor Hecht and The Hecht Valve Company, Inc. v. ACF Industries, Incorporated, Chrysler Corporation and General Motors Corporation.* The order (1) set aside a previous stay order entered by the Honorable Dorwin W. Suttle, another Judge of the same

District Court, (2) overruled ACF Industries' *forum non conveniens* motion, and (3) overruled ACF's motion to dismiss for lack of venue. It was stipulated on oral argument that Respondent's brief filed April 11, 1967 should be treated as its answer to the petition for mandamus required by Fifth Circuit Rule 13a.

ACF, on behalf of two of its employees, and Victor Hecht, each separately submitted an application for a patent on the same or substantially the same carburetor valve. Inadvertently overlooking ACF's pending application, the Patent Office issued a patent to Hecht. The Patent Office thereafter declared an interference to determine which applicant should be awarded the patent.[1]

While the interference proceeding was pending, Hecht filed an action in the Western District of Texas against ACF and its customers, General Motors Corporation and Chrysler Corporation, alleging infringement of his patent.[2] Eleven days later, ACF filed a suit in the District of Kansas against Hecht, asking for a declaratory judgment that Hecht's patent was invalid and that therefore there was no infringement, and an injunction restraining Hecht and Hecht Valve Company[3] from bringing infringement actions against cus-

[1] An interference is an administrative proceeding initiated by the commissioner pursuant to 35 U.S.C.A. § 135 to determine priority of invention as between two or more applicants. See Tennessee Valley Authority v. Monsanto Chemical Co., 5 Cir. 1967, No. 22668, decided July 19, 1967; 2 Walker on Patents (Deller's ed.) § 189.

[2] See 35 U.S.C.A. § 281.

[3] Hecht is a resident of Haysville, Kansas. Hecht Valve Company, a Kansas corporation having its sole place of business in Haysville, manufactures carburetor valves as the exclusive licensee under Hecht's patent.

tomers of ACF. Hecht and Hecht Valve Company counterclaimed, charging infringement of the Hecht patent.

ACF filed a motion to dismiss Hecht's Texas action for lack of venue and a *forum non conveniens* motion. This later motion sought a transfer of the Texas action to the Eastern District of Missouri pursuant to 28 U.S.C.A. §1404 (a), or in the alternative a stay of the Texas action. On original hearing, Judge Suttle made no ruling on either the motion to dismiss or the motion to transfer. He did, however, stay all proceedings in the Texas action pending "determination of the liability issue, the validity of the patent, in other words, on the issue in that Kansas case."[4]

Subsequently, the Patent Office decided the interference, awarding priority of one claim to Hecht and priority of another claim to ACF. ACF then filed a civil action in the District of Kansas against Hecht and the Hecht Valve Company to review the Patent Office's award to Hecht on one of the claims.[5] Hecht and Hecht Valve Company cross-claimed, asking for review of the award to ACF. This second

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[4] Judge Suttle determined that the convenience of the parties, the residences of the principal witnesses, and the interest of justice suggested that the issues should be decided in Kansas. Judge Suttle was particularly impressed with the fact that Hecht, the plaintiff in the Texas action, was from Kansas. ACF, a New Jersey corporation having its principal place of business in New York, New York, manufactures carburetors and carburetor valve assemblies solely at its Carter Carburetor Division which has its only plant and place of business in St. Louis, Missouri.

[5] See 35 U.S.C.A. § 146.

civil action was consolidated with the first action filed by ACF.[6]

After this consolidation, Hecht moved in the Texas court to vacate the stay order. Judge Suttle in denying the motion noted that Hecht had been forum shopping and there were "no known witnesses in Texas in this case."

Six months after this ruling by Judge Suttle, The Honorable Ernest Guinn took the oath of office as a United States District Judge for the Western District of Texas. Judge Guinn took over the civil docket for the district court. Hecht presented to Judge Guinn a motion to set aside Judge Suttle's stay order. After a hearing, Judge Guinn granted the motion and set aside the stay order. In a later order, Judge Guinn denied ACF's motion to dismiss for lack of venue or to transfer pursuant to §1404(a).

Desiring to take advantage of 28 U.S.C.A. §1292(b), ACF requested Judge Guinn to amend his order to indicate the advisability of an immediate appeal of an otherwise non-appealable interlocutory order.[7] Judge Guinn denied this request, and ACF filed its petition for writ of mandamus.

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[6] The Kansas district court denied without prejudice a motion by Hecht to stay proceedings pending the outcome of the Texas action. The court also refused to dismiss the Kansas actions for lack of jurisdiction. We agree with the Kansas district court that the Kansas actions were not subject to dismissal on the ground that the claims should have been filed in the Texas infringement action as compulsory counterclaims under Rule 13(a), Fed. R. Civ. P. See Bellmore Sales Corporation v. Winfield Drug Stores, Inc., S.D. N.Y. 1960, 187 F. Supp. 161, 162; Local Union 499 v. Iowa Power & Light Co., S.D. Iowa, 1964, 224 F. Supp. 731, 738; 1A Barron & Holtzoff, Federal Practice & Procedure, § 394.1, p. 584, et seq.; see also Rule 82 Fed. R. Civ. P.

[7] See In re Humble Oil & Refining Co., 5 Cir. 1962, 306 F. 2d 567.

A mandamus should be issued by an appellate court "in the exceptional case where there is a clear abuse of discretion or 'usurpation of judicial power.'" *Bankers Life and Casualty Co. v. Holland*, 1953, 346 U.S. 379, 383. *La Buy v. Howes Leather Co.*, 1957, 352 U.S. 249.[8] Our primary concern, therefore, is to determine whether *vel non* Judge Guinn abused his discretion in setting aside the order staying the Texas proceedings pending the outcome of the Kansas action. We hold that he did and grant the writ.[9]

The petition for mandamus seeks rulings on several issues. In substance, we are asked to hold either (1) that Judge Guinn abused his discretion in vacating the order entered by Judge Suttle since there was no change in circumstances warranting such vacation; or (2) that, irrespective of the propriety of one district judge vacating the order of another district judge, Judge Guinn abused his discretion in not granting the petitioner's *forum non conveniens* motion to stay proceedings.[10]

A stay pending the outcome of litigation between the same parties involving the same or controlling issues is an

[8] See 28 U.S.C.A. § 1651.

[9] A writ of mandamus may be issued to vacate orders denying transfer motions, Minnesota Mining & Manufacturing Co. v. Platt, 7 Cir. 1965, 345 F. 2d 681; Chicago, Rock Island & Pacific RR Co. v. Igoe, 7 Cir. 1955, 220 F. 2d 299; and to review a district court's grant or refusal of a stay of proceedings, Pet Milk Company v. Ritter, 10 Cir. 1963, 323 F. 2d 586. See: Schlagenhauf v. Holder, U.S. District Judge for the Southern District of Indiana, 379 U.S. 104 (1964); Beacon Theatres, Inc. v. Westover, U.S. District Judge, 359 U.S. 500 (1959).

[10] We are also requested to hold that Judge Guinn abused his discretion in denying ACF's motion to dismiss for lack of venue. We deny that request. The *forum non conveniens* motion requested a transfer of the proceedings pursuant to 28 U.S.C.A. § 1404(a) or a stay pending disposition of the Kansas action. The petition for mandamus urges only a stay of the Texas proceedings.

acceptable means of avoiding unnecessary duplication of judicial machinery. *Landis v. North American Co.*, 1936, 299 U.S. 248.[11] In this case the stay was most appropriate, since the Kansas court was considering the Patent Office decision in the interference proceeding.[12] Further the parties and most of the principal witnesses resided in or near the Kansas district,[13] and the Kansas proceedings seemed more likely to reach a decision before the Texas court would conclude its findings. A stay order would surely avoid an unwanted and highly undesirable race by each party to obtain a decision from the particular district court reacting most favorably to its position. *Cf. General Tire & Rubber Co. v. Watkins*, 4 Cir. 1967, 373 F. 2d 361.

We are not asked to order the transfer of the Texas action pursuant to 28 U.S.C.A. §1404(a).[14] A stay order has virtually the same effect, and is granted for practically the same

[11] See also Ex parte Tokio Marine & Fire Ins. Co., Ltd., 5 Cir. 1963, 322 F. 2d 113; Leesona Corp. v. Cotwool Mfg. Corp., 4 Cir. 1963, 315 F. 2d 538. Cf Amerado Petroleum Corp. v. Marshall, 5 Cir. No. 24019, decided July 31, 1967; Cessna Aircraft Co. v. Brown, 10 Cir. 1965, 348 F. 2d 689.

[12] A final judgment in the Kansas action reviewing the Patent Office decision will practically dispose of all but the damage issues in the Texas action. It is obvious that Hecht's right to his patent should be decided prior to deciding if there has been an infringement of the claims in his patent.

[13] Judge Suttle's finding and the preliminary pretrial order of the Kansas court recognize that the predominant number of witnesses were from Wichita, Kansas, and St. Louis, Missouri. Neither party is from Texas and ACF has no intention of calling any witnesses who reside in Texas.

[14] "§ 1404. *Change of venue*

"(a) For the convenience of parties and witnesses, in the interest of justice, a district court may transfer any civil action to any other district or division where it might have been brought."

Since a transfer is not requested, we need not determine if the Texas suit might have been brought in the Kansas court. See Hoffman v. Blaski, 1960, 363 U.S. 335.

reasons that motivate a court in granting a transfer motion. Some of the cases dealing with section 1404(a) are, therefore instructive.

The Supreme Court in *Van Dusen v. Barrack*, 1964, 376 U.S. 612, 616, stated: "Section 1404(a) reflects an increased desire to have federal civil suits tried in the federal system at the place called for in the particular case by considerations of convenience and justice."

In *Koehring Company v. Hyde Construction Co.*, 5 Cir. 1963, 324 F. 2d 295, this Court carefully considered the criteria to be considered in a motion for change of venue. We noted the residence of the witnesses, the convenience of the parties, and the opportunity of reaching a judgment without unnecessary delay. In the "interest of justice," we concluded that the cause should be transferred.[15]

Hecht will not lose his claim because of the stay order. He has counterclaimed in the Kansas action alleging infringement of his patent. Any relief he is entitled to can be granted by the Kansas court. See *Chas. Pfizer & Co. v. Olin Mathieson Chemical Corp.*, N.D. Ga. 1955, 131 F. Supp. 21, appeal dismissed, 5 Cir. 1955, 225 F. 2d 718; *Ex parte Chas. Pfizer & Co.*, 5 Cir. 1955, 225 F. 2d 720.[16]

Judge Guinn indicated that since venue was proper in the Western District of Texas, he would not apply the doctrine

[15] See Gulf Oil Corp. v. Gilbert, 1947, 330 U.S. 501; Chicago, Rock Island & Pacific RR Co. v. Igoe, 7 Cir. 1955, 220 F. 2d 299.

[16] For other cases involving change of venue of patent infringement suits, see Clayton v. Warlick, 4 Cir. 1956, 232 F. 2d 699; Rayco Manufacturing Co. v. Chicapee Manufacturing Co., S.D. N.Y. 1957, 148 F. Supp. 588. Paragon-Revolute Corp. v. C. F. Pease Co., D.Del. 1954, 120 F. Supp. 488.

of *forum non conveniens* by either staying the Texas proceedings or transferring the action to the Kansas district. That position completely overlooks the dictates of *Gulf Oil Corp. v. Gilbert*, 1947, 330 U.S. 501, the instructions of *Norwood v. Kirkpatrick*, 1955, 349 U.S. 29, and the intent of section 1404(a).[17] The "convenience of parties" and "the interest of justice" are to guide courts in applying the *forum non conveniens* doctrine. These factors also govern the use of a stay order. The fact that venue was proper in the Texas court does not permit these governing factors to be overlooked. On the contrary, section 1404(a) assumes proper venue and stay orders are permissible only when venue does exist.[18]

We find no occasion to elaborate on the case law which has considered the problems involved when one district judge vacates or contradicts the decision of another district judge. See *United States v. Koenig*, 5 Cir. 1961, 290 F. 2d 166; *Prack v. Weissinger*, 4 Cir. 1960, 276 F. 2d 446. Writs of mandamus may be issued if a judge abuses his discretion in vacating the order of another judge of the same court. *Cf. Ex parte Tokio Marine & Fire Ins. Co., Ltd.*, 5 Cir. 1963, 322 F. 2d 113; *United States v. United States District Court*, 8 Cir. 1953, 226 F. 2d 238.[19] Such an abuse of discretion

[17] See also Van Dusen v. Barrack, 1964, 376 U.S. 612, 634.

[18] If venue does not exist, the action should be dismissed or, if justice requires, transferred pursuant to 28 U.S.C.A. § 1406(a).

[19] This Court has supervisory control over the district courts of this Circuit to insure proper judicial administration. La Buy v. Howes Leather Co., 1957, 352 U.S. 249, *reh. den.*, 352 U.S. 1019. The All Writs Act, 28 U.S.C.A. § 1651(a), confers on this Court the power to issue writs of mandamus in exceptional circumstances. Cf. Beacon Theatres, Inc. v. Westover, 1959, 359 U.S. 500. See also Thomas v. United States, 5 Cir. 1966, 368 F. 2d 941, 947, n. 13 and n. 14.

occurred here. There was no sufficient basis for Judge Guinn to vacate Judge Suttle's order. The circumstances existing at the time Judge Suttle denied Hecht's first motion to vacate the stay order were the same as the circumstances when Judge Guinn granted Hecht's second motion. Judge Guinn made no finding that Judge Suttle erred in granting his stay order.[20]

We are further convinced that Judge Guinn erred because we find that a stay order was needed. In determining if a judge abused his discretion, we must look at the correctness of his decision and the reasons for it.[21] In this case, we conclude that Judge Guinn's order was not proper and has no sufficient reason to support it. We hold both that Judge Guinn abused his discretion in vacating Judge Suttle's stay order, and that a stay order should be granted.

Let a Writ of Mandamus issue directing the Respondent (1) to vacate and set aside the order of December 16, 1966; and (2) to enter an order staying this cause pending the outcome of Civil Actions No. W-3222 and No. W-3558 pending in the District Court of Kansas.

WRIT GRANTED.

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[20] See Dictograph Products Company v. Sonotone Corporation, 2 Cir. 1956, 230 F. 2d 131; Cf. Castner v. First National Bank of Anchorage, 9 Cir. 1960, 278 F. 2d 376; Ward v. Louisiana, E.D. La. 1963, 224 F. Supp. 252, *aff'd*, 5 Cir. 1965, 347 F. 2d 234.

[21] Even if we discern some grounds for the judge's decision, we must decide whether those grounds outweigh the undesirability of setting aside a decision of another district judge.

APPENDIX B

U. S. COURT OF APPEALS
FILED
OCT 9 1967
EDWARD W. WADSWORTH
CLERK

In the

UNITED STATES COURT OF APPEALS

For the Fifth Circuit

No. 24613

ACF INDUSTRIES, INCORPORATED,

Petitioner,

versus

THE HONORABLE ERNEST GUINN,
United States District Judge,

Respondent.

ON PETITION FOR WRIT OF MANDAMUS

ON PETITION FOR REHEARING EN BANC

(October 9, 1967)

Before RIVES and DYER, Circuit Judges, and JOHNSON, District Judge.

PER CURIAM:

The Petition for Rehearing is DENIED and no member of this panel nor Judge in regular active service on the Court having requested that the Court be polled on rehearing en banc, Rule 25 (a), subpar. (b), the Petition for Rehearing En Banc is DENIED.

APPENDIX C

In the
UNITED STATES COURT OF APPEALS
For the Fifth Circuit

Petition No. 24613

ACF INDUSTRIES, INCORPORATED,
Petitioner,

versus

THE HONORABLE ERNEST GUINN,
United States District Judge,
Respondent.

Before RIVES and DYER, Circuit Judges, and JOHNSON, District Judge.

JUDGMENT

This cause came on to be heard before this Court on ACF Industries' petition for writ of mandamus, and the petition having been argued by counsel and a decision having been duly rendered,

IT IS ORDERED AND ADJUDGED that the petition be, and it is hereby, granted as indicated in the opinion of this Court dated September 6, 1967. In view of this Court's

opinion, it is assumed that formal issuance of the writ will be unnecessary. The Court therefore directs that the writ issue only on further application by the petitioner.

Entered this 6th day
of September, 1967.

/s/ Richard T. Rives
United States Court of Appeals

APPENDIX D

No. 24,613

In the
UNITED STATES COURT OF APPEALS
For the Fifth Circuit

ACF INDUSTRIES, INCORPORATED,

Petitioner,

v.

THE HONORABLE ERNEST GUINN
United States District Judge

Respondent.

APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE WESTERN DISTRICT OF TEXAS

Before RIVES and DYER, Circuit Judges, and JOHNSON, District Judge.

ORDER RECALLING AND STAYING JUDGMENT ISSUED AS MANDATE

ON CONSIDERATION of the petition of Appellants for recall and stay of judgment issued as mandate in the above numbered and entitled cause, to enable appellants to apply for and obtain a writ of certiorari from the Supreme Court of the United States, IT IS ORDERED that the judgment issued as mandate to the Clerk of the United States Dis-

trict Court, at Pecos, Texas, on September 6, 1967, be recalled and stayed for a period of thirty days, the stay to continue in force until the final disposition of the case by the Supreme Court, provided that within thirty days from the date of this order there shall be filed with the clerk of this court the certificate of the clerk of the Supreme Court that certiorari petition and record have been filed. It is further ordered that the clerk shall issue the judgment as mandate upon the filing of a copy of an order of the Supreme Court denying the writ, or upon the expiration of thirty days from the date of this order, unless the above mentioned certificate shall be filed with the clerk of this court within that time.

Done for the Court in the light of the Fifth Circuit Rule 32.

/s/ RICHARD T. RIVES
United States Circuit Judge

Dated this 8th day of December, 1967.

(ORIGINAL FILED—DECEMBER 13, 1967)

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The following abbreviations are used in this brief:

R. — Record

P. — Petition for Writ of Certiorari

P. App. — Appendices to the Petition

R. App. — Appendices to this Respondent's Brief in Opposition to the Petition

IN THE

Supreme Court of the United States

OCTOBER TERM, 1967

THE HONORABLE ERNEST GUINN, United States District Judge, VICTOR HECHT and THE HECHT VALVE COMPANY, INC., *Petitioners,* v. ACF INDUSTRIES, INCORPORATED, *Respondent.*	No. 970

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

There is nothing in this case which warrants review by this Court.

The decision of the Court of Appeals for the Fifth Circuit is manifestly correct in holding (1) that it was an abuse of discretion for Judge Guinn (United States District Judge for the Western District of Texas) to review and reverse the decision previously rendered by Judge Suttle of the same Court granting respondent's *forum non conveniens* motion, where there had been no change in circumstances and where Judge Guinn made no finding that Judge Suttle had erred in deciding that motion; and (2) that, regardless of Judge Suttle's previous decision, it was an abuse of discretion for Judge Guinn to deny respondent's *forum non conveniens* motion on its merits, where the forum had no connection with either the parties or the

facts and where the denial of that motion would permit litigation between the same parties involving the same patent to proceed in two different District Courts.

There is no conflict with any decision of this Court or with any decision in any other Circuit. There has been no departure from the accepted and usual course of judicial proceedings. No question of public importance is involved here. In short, there is no special or important reason why the writ prayed for should be granted.

OPINIONS BELOW

The opinion of the Court of Appeals for the Fifth Circuit, granting the application of respondent here for a writ of mandamus, is reported at 384 F. 2d 15 and is printed in petitioners' Appendix A.

Judge Suttle's opinion (delivered from the bench) granting respondent's *forum non conveniens* motion is printed as Appendix A to this brief.

Judge Guinn did not render any opinion in reversing Judge Suttle's decision. Judge Guinn's order is printed as Appendix B to this brief.

JURISDICTION

The jurisdictional requisites are set forth in the petition.

QUESTIONS PRESENTED

The eighteen questions presented by petitioners are based on asserted facts that are without support in the record.

For example, question 8 (P. 4) asks whether the Court of Appeals can overrule this Court's holding in *Hoffman* v.

Blaski; 363 U. S. 335 (1960), and thereby permit Judge Suttle to transfer the action below to Kansas. But the opinion of the Court of Appeals does not purport to overrule this Court. Respondent never sought, and Judge Suttle did not make, a transfer to Kansas. On the contrary, the Court of Appeals said (P. App. A-6, footnote 14):

> "Since a transfer is not requested, we need not determine if the Texas suit might have been brought in the Kansas court. See *Hoffman* v. *Blaski*, 1960, 363 U. S. 335."

The only real question presented here is whether petitioner is entitled to another hearing on the merits. But, as stated in *Magnum Co.* v. *Coty*, 262 U. S. 159, 163 (1923):

> "The jurisdiction [to bring up cases by certiorari] was not conferred upon this Court merely to give the defeated party in the Circuit Court of Appeals another hearing."

STATUTES INVOLVED

In addition to the statutes set forth in the petition*, this case involves the following statutes:

28 U. S. C. § 1651(a)—Writs

> "The Supreme Court and all courts established by Act of Congress may issue all writs necessary or appropriate in aid of their respective jurisdictions and agreeable to the usages and principles of law."

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*The second statute quoted in the petition (P. 6) is 28 U. S. C. § 1338(a), not 28 U. S. C. § 1400(a) as stated in the petition.

28 U. S. C. § 2201—Creation of remedy

"In a case of actual controversy within its jurisdiction, except with respect to Federal taxes, any court of the United States, upon the filing of an appropriate pleading, may declare the rights and other legal relations of any interested party seeking such declaration, whether or not further relief is or could be sought. Any such declaration shall have the force and effect of a final judgment or decree and shall be reviewable as such."

35 U. S. C. § 135(a)—Interferences

"Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be. The question of priority of invention shall be determined by a board of patent interferences (consisting of three examiners of interferences) whose decision, if adverse to the claim of an applicant, shall constitute the final refusal by the Patent Office of the claims involved, and the Commissioner may issue a patent to the applicant who is adjudged the prior inventor. A final judgment adverse to a patentee from which no appeal or other review has been or can be taken or had shall constitute cancellation of the claims involved from the patent, and notice thereof shall be endorsed on copies of the patent thereafter distributed by the Patent Office."

35 U. S. C. § 146—Civil action in case of interference

"Any party to an interference dissatisfied with the decision of the board of patent interferences on the question of priority, may have remedy by civil action, if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints or as provided in section 141 of this title, unless he has appealed to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided. . . ."

35 U. S. C. § 281—Remedy for infringement of patent

"A patentee shall have remedy by civil action for infringement of his patent."

STATEMENT OF THE CASE

The petition before this Court concerns three cases involving a patent issued to Hecht for a carburetor valve. One case, brought by Hecht, is in the Western District of Texas against ACF and two customers for alleged infringement of the Hecht patent. A second case, pending in the District of Kansas, was brought by ACF for a declaratory judgment that the Hecht patent is invalid and not infringed. The third case, also in Kansas, is to review a decision of the United States Patent Office in an interference proceeding between Hecht and ACF. The two Kansas cases have been consolidated for trial.

Petitioner's statement is deficient in two principal respects. First, it fails to mention the facts bearing on the convenience of the parties and witnesses as to the place of

trial and, second, it fails to mention the Kansas case to review the Patent Office decision in the interference proceeding.

Facts Relevant To
Forum Non Conveniens

Victor Hecht is a resident of Kansas. The Hecht Valve Company is a Kansas corporation having its sole place of business in Kansas (P. App. A-2, footnote 3; R. 36). Neither Hecht nor The Hecht Valve Company has any connection with Texas, nor do any of their witnesses reside in Texas. All of their witnesses are residents of Kansas (R. 36-8). A pre-trial order in the two Kansas actions, listing the witnesses to be called at the trial, confirmed that all of the witnesses for Hecht were from Kansas (R. 622).

ACF Industries, a New Jersey corporation, has its principal place of business in New York, N. Y. It manufactures and sells the accused carburetors by its Carter Carburetor Division whose only plant and place of business is in St. Louis, Mo. (P. App. A-3, footnote 4; R. 37). Neither ACF nor any of its divisions manufactures any product in the Western District of Texas. Its Carter Carburetor Division does not even maintain an office in that district. None of ACF's witnesses resides in Texas (R. 37-8 and 621).

The decision to sue ACF in Texas was made by Hecht's Kansas attorneys. It was only after this decision that Texas counsel was engaged to represent Hecht (R. 254). Hecht admitted that there was no reason for bringing suit in Texas other than the fact that his trial attorneys resided in Texas (R. 297). He also testified that he would have preferred to sue ACF in Kansas because it would have been more convenient for him and his witnesses and less expensive (R. 318-9).

In holding that Judge Suttle's decision to stay the Texas action was correct, the Court of Appeals referred specifically to Judge Suttle's finding that Hecht had been "forum shopping" and that there were "no known witnesses in Texas in this case" (P. App. A-4, R. 498, 499).

Chronology of the Three Actions

This patent dispute between Hecht and ACF began in the U. S. Patent Office.

ACF filed a patent application on behalf of two employees disclosing a carburetor valve.

A few months later, Hecht filed his application which ultimately resulted in the patent in suit. This application claimed a carburetor valve similar to that shown in ACF's earlier application. If the particular Patent Office examiner in charge of Hecht's application had been aware of ACF's pending application, an interference under 35 U. S. C. § 135 would have been declared to determine the issue of priority as between the rival applicants. But the Patent Office examiner failed to discover ACF's application with the result that no interference was declared and Hecht's patent issued on September 18, 1962 (R. 828).

ACF then became aware of Hecht's claims and notified the Patent Office of its error. The Patent Office admitted its mistake in prematurely granting Hecht a patent and declared an interference. This is the subject matter of the second Kansas action. If Hecht loses the claims in the interference they will be cancelled from his patent by the force of 35 U. S. C. § 135.

On June 18, 1964, while the interference was pending, undecided in the Patent Office, Hecht filed the Texas suit alleging infringement of his patent, including the claims involved in the interference (R. 3).

Eleven days later, on June 29, 1964, ACF filed its first Kansas action against Hecht and his exclusive licensee, The Hecht Valve Company, for a declaratory judgment that the Hecht patent was invalid and not infringed (R. 10). Hecht and his valve company counterclaimed for infringement of the same claims as in the Texas action (R. 601).

ACF filed a *forum non conveniens* motion in the Texas action (R. 30) to assert:

> (1) that the Western District of Texas had no connection with either the parties or the facts of the litigation;
>
> (2) that only two judicial districts had any connection with the parties and the facts of the litigation, the District of Kansas and the Eastern District of Missouri;
>
> (3) that ACF stood ready to proceed with the litigation in either of these two convenient and logical forums; and
>
> (4) that unless Hecht came forward with a reason cognizable at law for selecting the Western District of Texas, it must be concluded that Hecht had indulged in forum shopping.

ACF sought relief under the doctrine of *forum non conveniens* by a stay of the Texas action pending final judgment in the Kansas action or, in the alternative, by a transfer of the Texas action to the Eastern District of Missouri under 28 U. S. C. § 1404(a).

The hearing before Judge Suttle extended over three days (R. 64-460). Affidavits and depositions were received in evidence and eight witnesses, including Hecht, testified. Judge Suttle granted ACF's motion and stayed the Texas action pending final judgment in the Kansas action

(R. App. A). He did not rule on a pending venue motion by ACF because his decision to stay the Texas action made such a ruling unnecessary.

On December 28, 1965, the Patent Office decided the interference, splitting the award of priority evenly—one claim to Hecht and the other to ACF.

Hecht filed a motion to vacate the stay order in the Texas case (R. 468-73 and 482). Judge Suttle denied the motion, finding that there had been no change in circumstances which would cause him to vacate his stay order (R. 492-537).

While Judge Suttle was on vacation, Hecht presented an *ex parte* motion to newly appointed Judge Guinn which sought to set aside Judge Suttle's stay order entered almost one year earlier (R. 651-62). Hecht asserted as a change in circumstances a denial by the Kansas Court of his motion to dismiss the Kansas action for lack of jurisdiction (R. 660). Judge Guinn issued an Order to Show Cause why Hecht's motion should not be granted (R. 663).

When Judge Suttle returned from vacation, he resumed his role in the Texas action and called upon ACF to file a brief in opposition to Hecht's motion to set aside the stay order (R. 664), which ACF filed on October 4, 1966 (R. 667). On October 6, 1966, Hecht sought and obtained from Judge Suttle an extension of time to answer ACF's opposing brief up to November 1, 1966 (R. 678).

On October 7, 1966, before Judge Suttle had received Hecht's answer, an order was filed in the Texas Court whereby the Civil and Criminal Dockets were divided between Judge Guinn and Judge Suttle (R. 679). The Civil Docket was assigned to Judge Guinn and the Criminal Docket was assigned to Judge Suttle. This order also contained the following provision:

> "It is provided, however, that nothing herein shall be construed as prohibiting the Judges from assisting one another with such foregoing assignment in any manner they may see fit. The disqualification of any Judge in any case assigned to him shall automatically assign such case to the one not disqualified immediately upon certification of disqualification by such Judge."

The hearing on Hecht's motion to set aside Judge Suttle's stay order was held before Judge Guinn (R. 682). No witnesses testified nor were any affidavits or depositions received in evidence at this hearing. On four separate occasions during the course of this hearing, Judge Guinn expressed his intention to have a full discussion with Judge Suttle before ruling on Hecht's motion (R. 698, 706, 716-7 and 750).

Judge Guinn entered an order which set aside Judge Suttle's stay order, overruled ACF's *forum non conveniens* motion, denied ACF's motion to dismiss for lack of venue and set the Texas action for jury* trial (R. App. B).

Judge Guinn did not file any opinion with his order or make any findings to explain the reason for his reversal of Judge Suttle's decision on ACF's *forum non conveniens* motion.

ACF asked Judge Guinn to modify his order to include the certification language of 28 U. S. C. § 1292(b) so that ACF could take an interlocutory appeal and resolve this difference of opinion between two Judges of the same Court (R: 784-9). Judge Guinn denied ACF's request (R. 795).

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*None of the parties had made a demand for a jury trial. In fact, no answer to Hecht's complaint had been filed when Judge Guinn entered his order.

ACF filed its petition for a writ of mandamus on April 3, 1967 and on September 6, 1967, the Court below granted this petition (P. App. A). On October 9, 1967, the Court below denied Hecht's petition for rehearing and for rehearing *en banc* (P. App. B).

The complications of this litigation have arisen because of a mistake by the Patent Office and two ill-conceived acts by Hecht:

1. The Patent Office made a mistake in prematurely granting Hecht a patent without first determining the issue of priority between Hecht and the two employees of ACF.

2. Hecht brought suit against ACF for infringement while the interference was still pending, knowing that the claims in interference would be cancelled from his patent by an adverse decision.

3. Hecht brought his suit against ACF in the Western District of Texas which had no connection with either the parties or the facts of the litigation.

REASONS FOR DENYING THE WRIT

The Holding Of The Court Below Is Correct

1. It Was an Abuse of Discretion to Reverse the Prior Decision of Judge Suttle

The Court below held that it was a clear abuse of discretion for Judge Guinn to review Judge Suttle's decision on ACF's *forum non conveniens* motion and to reverse that decision where there had been no change in circum-

stances* and where Judge Guinn made no finding that Judge Suttle had erred in deciding that motion (P. App. A-9).

Judge Suttle was "available" to hear and rule on Hecht's second motion to vacate his stay order. This is established not only by the saving provision of the order dividing the Civil and Criminal Dockets of that Court (*supra*, pp. 9-10), but also by Judge Guinn's repeated statement of his intention to have a full discussion with Judge Suttle before ruling on Hecht's motion to vacate the stay order (*supra*, p. 10).

Judge Guinn did not find that Judge Suttle had erred or abused his discretion in rendering his prior decision on ACF's *forum non conveniens* motion. On the contrary, Judge Guinn stated at the hearing that he recognized that there was a basis for the stay order (R. 692), but added that "I don't agree with Judge Suttle about the question of *forum non conveniens*" (R. 697). In plain terms, Judge Guinn substituted his discretion for the discretion previously exercised by Judge Suttle.

Under practically identical circumstances, the Court of Appeals for the Third Circuit in *United States* v. *Wheeler*, 256 F. 2d 745 (3 Cir. 1958), cert. denied 358 U. S. 873 (1958), held that the action of the second Judge was an abuse of discretion, observing that the rule prohibiting such action by the second Judge was "designed to prevent shop-

*In an effort to show a change in circumstances, the petition asserts (P. 37) that at the hearing before Judge Guinn, General Motors admitted that it could be liable as a manufacturer rather than as a mere customer. No such admission was made by General Motors (R. 740-1). Subsequent to the hearing and before Judge Guinn issued his order, counsel for General Motors reaffirmed the customer status of General Motors and again stated that General Motors does not manufacture a carburetor valve of the type which is the subject of the Hecht patent (R. 773-4). This was confirmed by affidavit (R. 812-6).

ping about by the defeated party for a judge more favorably disposed to whom a petition for reconsideration may be presented" (256 F. 2d at 748). There is evidence in this case of such shopping (*supra*, p. 9).

The holding in the *Wheeler* case was followed by the Court of Appeals for the Fourth Circuit in *United States* v. *Whiting*, 311 F. 2d 191, 196 (4 Cir. 1962), cert. denied 372 U. S. 935 (1963), and was applied by the Court of Appeals for the Ninth Circuit in *Johnson* v. *England*, 356 F. 2d 44, 52 (9 Cir. 1966), cert. denied 384 U. S. 961 (1966).

In *The Material Service*, 11 F. Supp. 1006 (N. D. Ill. 1934), aff'd *sub. nom. Leathem Smith-Putnam Navigation Co.* v. *Osby*, 79 F. 2d 280 (7 Cir. 1935), cert. denied 296 U. S. 653 (1935), Judge Carpenter had entered an order enjoining the plaintiffs from proceeding with suits pending in the state courts and had denied a motion for modification of his order. Subsequently another motion to modify the order was made in the case which was then before Judge Woodward of the same Court. Judge Woodward denied the motion, holding:

> "It is well settled that a judge may not overrule a prior decision of another judge of the same court in the same case. [citing cases] There has been no essential change in the record since Judge Carpenter issued the injunction and refused to modify it." (p. 1007)

All of the foregoing cases observe the general principle stated in 21 C. J. S. § 501 (p. 768):

> "Notwithstanding a few decisions to the contrary as to rulings on demurrers, it is generally considered that, in the same case, one judge may not review and overrule the prior decisions, or vacate or

> modify the prior orders, of another judge of the same court or possessing equal and coordinate power and jurisdiction, where the other judge is available at the time of the application to set aside or change his order or decision."

Two of the first statements of this principle in the Federal Courts were by Justices of this Court—Justice Miller in *Appleton* v. *Smith,* 1 Fed. Cas. 1075, No. 498, (C. C. D. Ark. 1870) and Justice Field in *Cole Silver Min. Co.* v. *Virginia & Gold Hill Water Co.,* 6 Fed. Cas. 72, 74, No. 2,990, (C. C. D. Nev. 1871).

Hecht endeavors to avoid these authorities by asserting that Judge Sutttle assigned the motion to vacate the stay order to Judge Guinn for hearing and that Judge Suttle did this because he "thought it of sufficient merit" (P. 15). From these asserted facts, Hecht argues that Judge Guinn reversed the original ruling of Judge Suttle with the consent and agreement of Judge Suttle.

The record will not support Hecht. Judge Suttle did not assign Hecht's motion to Judge Guinn for hearing but rather these two judges decided to divide the entire Civil and Criminal Dockets of their Court (*supra,* p. 9). There is nothing in the record which would indicate that Judge Suttle saw any merit in Hecht's motion. On the contrary, Judge Suttle had not received all of the briefs on this motion when the docket was divided (*supra,* p. 9). The fallaciousness of Hecht's argument is exposed by Judge Guinn's statement that "I don't agree with Judge Suttle about the question of *forum non conveniens*" (R. 697).

2. It Was an Abuse of Discretion to Deny ACF's *Forum Non Conveniens* Motion

The Court below held that, regardless of Judge Suttle's original decision, it was a clear abuse of discretion for

Judge Guinn to deny on its merits ACF's *forum non conveniens* motion (P. App. A-6 through A-9).

Prior to the enactment of 28 U. S. C. § 1404(a) in 1948, the doctrine of *forum non conveniens* usually resulted in a dismissal of the action and therefore the plaintiff's choice of forum was a dominant factor, rarely to be disturbed. *Gulf Oil Corp.* v. *Gilbert,* 330 U. S. 501, 509 (1947).

Shortly after the *Gulf Oil* case, Congress enacted the transfer statute, 28 U. S. C. § 1404(a), which permitted the application of the doctrine of *forum non conveniens* without the harsh result of dismissal. In *Norwood* v. *Kirkpatrick,* 349 U. S. 29 (1955), this Court considered the transfer statute and stated:

> "When Congress adopted § 1404(a), it intended to do more than just codify the existing law on *forum non conveniens.* As this Court said in *Ex parte Collett,* 337 U. S. 55-61, Congress, in writing § 1404(a), which was an entirely new section, was revising as well as codifying. The harshest result of the application of the old doctrine of *forum non conveniens,* dismissal of the action, was eliminated by the provision in § 1404(a) for transfer. When the harshest part of the doctrine is excised by statute, it can hardly be called mere codification. As a consequence, we believe that Congress, by the term 'for the convenience of parties and witnesses, in the interest of justice,' intended to permit courts to grant transfers upon a lesser showing of inconvenience." (p. 32)

More recently, this Court in *Van Dusen* v. *Barrack,* 376 U. S. 612, 616 (1964), stated:

> "Section 1404(a) reflects an increased desire to have federal civil suits tried in the federal system at

the place called for in the particular case by considerations of convenience and justice."

The case of *Chas. Pfizer & Co.* v. *Olin Mathieson Chemical Corp.*, 131 F. Supp. 21 (N. D. Ga. 1955), appeal dismissed 225 F. 2d 718 (5 Cir. 1955), pet. for writ of mandamus denied 225 F. 2d 720 (5 Cir. 1955), involved a situation similar to that now before this Court. In that case, the district court transferred, under 28 U. S. C. § 1404(a), a patent infringement action to another district where the defendants had filed declaratory judgment actions fourteen days after commencement of the infringement action.

There is no doubt that a district court has the power to stay an action pending the outcome of another action in another district court. *Landis* v. *North American Co.*, 299 U. S. 248, 254-5 (1936). Because a stay under the doctrine of *forum non conveniens*, like a transfer under that doctrine, avoids the harshness of a dismissal, plaintiff's choice of forum is not a dominant factor in this application of that doctrine.

Notwithstanding that the Western District of Texas had no connection with the parties, witnesses or facts of this litigation (*supra*, pp. 6-7), Judge Guinn denied ACF's *forum non conveniens* motion. Although he did not render an opinion in denying that motion, certain statements that he made during the hearing explain his subsequent order. Judge Guinn said (R. 700) "If they [Hecht] have venue there is no such thing as 'Forum Shopping'" and that, if he found venue to be proper in the Western District of Texas, he would not apply the doctrine of *forum non conveniens* by stay or by transfer (R. 697). The Court below correctly held that Judge Guinn abused his discretion in taking this position because both the doctrine of *forum non conveniens* and the transfer statute assume that venue is proper (P. App. A-7 through A-8). In *Gulf Oil Corp.* v.

Gilbert, 330 U. S. 501, 504 (1947), this Court observed that "the doctrine of *forum non conveniens* can never apply if there is absence of jurisdiction or mistake of venue." Also in *Van Dusen* v. *Barrack,* 376 U. S. 612, 634 (1964), this Court said:

> "Although both sections [28 U. S. C. §§ 1404(a) and 1406(a)] were broadly designed to allow transfer instead of dismissal, § 1406(a) provides for transfer from forums in which venue is wrongly or improperly laid, whereas, in contrast, § 1404(a) operates on the premise that the plaintiff has properly exercised his venue privilege. This distinction underlines the fact that Congress, in passing § 1404(a), was primarily concerned with the problems arising where, despite the propriety of the plaintiff's venue selection, the chosen forum was an inconvenient one."

Judge Guinn also said that he would not consider the convenience of Hecht or of Hecht's witnesses (all residents of Kansas) and that he would assume that Hecht's attorneys had a valid reason for bringing suit in Texas (R. 701, 703, 705, 712-3). This is contrary to the approach taken by this Court in the *Gulf Oil* case:

> "The plaintiff himself is not a resident of New York, nor did any event connected with the case take place there, nor does any witness, with the possible exception of experts, live there. No one connected with that side of the case save counsel for the plaintiff resides there, and he has candidly told us that he was retained by insurance companies interested presumably because of subrogation. (330 U. S. at 509)

* * *

"Certainly to fix the place of trial at a point where litigants cannot compel personal attendance and may be forced to try their cases on deposition, is to create a condition not satisfactory to court, jury or most litigants. Nor is it necessarily cured by the statement of plaintiff's counsel that he will see to getting many of the witnesses to the trial and that some of them 'would be delighted to come to New York to testify.'" (330 U. S. at 511)

The same approach was followed in *Sypert* v. *Bendix Aviation Corporation,* 172 F. Supp. 480 (N. D. Ill. 1958), pet. for writ of mandamus denied 266 F. 2d 196 (7 Cir. 1959), cert. denied 361 U. S. 832 (1959), where the Court granted a transfer under 28 U. S. C. § 1404(a) for *forum non conveniens* (p. 486):

"In its evaluation of 'the convenience of parties and witnesses, in the interest of justice,' the Court has not discounted the personal inconvenience to the plaintiff which trial in this forum involves. By opposing the motion, plaintiff asserts that his convenience would best be served by its denial. But an argument of this sort does not affect the plain truth that the balance of convenience to this plaintiff lies in favor of the district in which he resides."

* * *

"The statute speaks of the 'interest of justice' and not the sole interest of the litigant opposing the motion. The Court may not disregard the inconvenience which would accrue to plaintiff's witnesses by trial in this forum."

Even if the convenience of the parties and of the witnesses were not considered, the interest of justice would

compel the conclusion that the Texas action should have been stayed. The Court below so held, stating that "[i]n this case the stay was most appropriate, since the Kansas court was considering the Patent Office decision in the interference proceeding" (P. App. A-6) and "[i]t is obvious that Hecht's right to his patent should be decided prior to deciding if there has been an infringement of the claims in his patent" (P. App. A-6, footnote 12).

The Kansas review action is a statutory action brought under 35 U. S. C. § 146 to obtain judicial review of the Patent Office decision in the interference. It cannot be transferred to the Western District of Texas.* The Patent Office interference decision on the Hecht patent cannot be reviewed in the Texas infringement action brought under 35 U. S. C. § 281. It can only be reviewed in the Kansas review action brought under 35 U. S. C. § 146. *Deltec, Inc.* v. *Laster,* 326 F. 2d 443, 444 (6 Cir. 1964); *Pangborn Corporation* v. *American Foundry Equip. Co.,* 159 F. 2d 88, 98 (3 Cir. 1946).

A final judgment in the Kansas review action, adverse to Hecht on any claim, will automatically cancel that claim from his patent by virtue of the following provision of 35 U. S. C. § 135(a), dealing with interferences:

> "A final judgment adverse to a patentee from which no appeal or other review has been or can be taken or had shall constitute cancellation of the claims in-

*Hecht filed a motion in the Kansas actions seeking to dismiss those actions for lack of jurisdiction or, in the alternative, to transfer those actions for *forum non conveniens* to the Western District of Texas (R. 796-801). The Kansas Court denied Hecht's motion to dismiss, holding that prior commencement of the infringement action in the Texas Court was not a jurisdictional bar to either of the Kansas actions (R. 821) and that the compulsory counterclaim bar does not arise until one action has proceeded to judgment (R. 822-3). The Kansas Court also denied Hecht's motion to transfer the actions to the Western District of Texas (R. 823-4).

> volved from the patent, and notice thereof shall be endorsed on copies of the patent thereafter distributed by the Patent Office."

What claims will remain in the Hecht patent will not be known until final judgment has been rendered in the Kansas review action.

If the Texas action had not been stayed, it would have been necessary for both the Kansas Court and the Texas Court to consider the same patent claims, to hear the testimony of many of the same witnesses and to be "educated" in much of the same factual background and technology. In *General Tire & Rubber Company* v. *Watkins,* 373 F. 2d 361 (4 Cir. 1967), cert. denied 386 U. S. 960 (1967), the Court of Appeals issued a writ of mandamus directing the lower Court to transfer the declaratory judgment patent action brought against General Tire by Firestone to the Northern District of Ohio where General Tire's suit against U. S. Rubber for infringement of the same patent was pending. The Court of Appeals directed transfer notwithstanding that the action below in the District of Maryland had been at trial for two and one-half years, pointing to the fact that the Ohio suit against U. S. Rubber could not be transferred to the District of Maryland and stating:

> "We turn now to our reasons for issuing the writ under the extraordinary circumstances of this case. We think the district court erred in its failure to weigh the impelling need for efficiency in the administration of our court system against the right of Firestone to continue the trial in a forum which no longer offered to it any convenience over the Ohio forum. Certainly the simultaneous trial of two suits in different circuits involving a number of identical questions of fact and law would result in a useless waste of judicial time and energy. Against the judicial time and effort already spent on the Maryland

> case must be weighed the fact that the Ohio judge either has been, or will have to be, 'educated' in much of the same factual background whether or not the Ohio case against Firestone can be consolidated with its companion case against U. S. Rubber." (p. 368)

With the Texas action stayed, all the issues between Hecht and ACF, including the interference issue, will be tried by and determined by one court, the United States District Court for the District of Kansas.

Petitioners' Arguments Are Without Merit

Some of the eighteen questions presented by the petition are based on the assertion that the decision of the Court below is in conflict with the prior decisions of this Court in *Hoffman* v. *Blaski*, 363 U. S. 335 (1960) and *Kerotest Mfg. Co.* v. *C-O-Two Co.*, 342 U. S. 180 (1952), and also in conflict with the decision of the Court of Appeals for the Seventh Circuit in *Sundstrand Corporation* v. *American Brake Shoe Company*, 315 F. 2d 273 (7 Cir. 1963).

There is no conflict with *Hoffman* v. *Blaski*, because the Texas action was not transferred to the District of Kansas (*supra*, pp. 3, 8). Likewise, there is no conflict with the *Kerotest* decision because in *Kerotest* the issue of *forum non conveniens* was not before and was specifically reserved by this Court (342 U. S. at 186):

> "And if the manufacturer is joined as an unwilling defendant in a *forum non conveniens*, he has available upon an appropriate showing the relief provided by § 1404(a) of the Judicial Code."

The same reservation was made by the Court of Appeals for the Seventh Circuit in the *Sundstrand* case:

> "The Supreme Court in *Kerotest* gave its approval to the normal procedural safeguards used to

protect litigants from having to do battle in an improper forum. One of these safeguards is the application of the doctrine of *forum non conveniens* under the provision of section 1404(a) of the Judicial Code." (315 F. 2d at 275)

* * *

"Sundstrand may move to intervene in the Maryland case and then move for a *forum non conveniens* transfer to the Northern District of Illinois or the customers may make the motion on their own behalf. We are not prepared to say that that court, in such a contingency, would fail to properly exercise its discretion." (315 F. 2d at 276)

Many of the eighteen questions presented by the petition are founded upon the assertion that an action in one district court cannot be stayed pending the outcome of another action in another district court. Such an assertion is refuted by this Court's decision in *Landis* v. *North American Co.*, 299 U. S. 248, 254-5 (1936):

"Viewing the problem as one of power, and of power only, we find ourselves unable to assent to the suggestion that before proceedings in one suit may be stayed to abide the proceedings in another, the parties to the two causes must be shown to be the same and the issues identical. Indeed, counsel for the respondents, if we understand his argument aright, is at one with us in that regard, whatever may have been his attitude at the hearing in the courts below. Apart, however, from any concession, the power to stay proceedings is incidental to the power inherent in every court to control the disposition of the causes on its docket with economy of time and effort for itself, for counsel, and for litigants.

> How this can best be done calls for the exercise of judgment, which must weigh competing interests and maintain an even balance."

In the *Landis* case, this Court recognized the power of the District Court Judge to stay the action before him pending the outcome of an action in another district court, notwithstanding that the issues and the parties in the other action were not identical. Petitioners assert (P. 25) that the *Landis* case *"held that it had to be an emergency creating a judicial scandal before this remedy* [stay] *should be used"* (emphasis in petition). This is not correct. What this Court said in the *Landis* case (299 U. S. at 255) was that there would be occasions where it would be a scandal to the administration of justice if the courts did not have the power to coordinate their business efficiently and sensibly.

The petition, at page 36, states the general rule that the court first acquiring jurisdiction should be allowed to proceed without interference from other courts under suits subsequently instituted. But here the Kansas Court did not interfere with the proceedings in the Texas action. The decision to stay the Texas action was made by Judge Suttle of the Texas Court and by the Court of Appeals for the Fifth Circuit.

The petition also questions the availability of the writ of mandamus in the present case. In *La Buy* v. *Howes Leather Co.*, 352 U. S. 249, 257, 259-60 (1957), this Court held that the writ of mandamus was available in cases of "clear abuse of discretion" and cases where "supervisory control of the District Courts by the Courts of Appeals is necessary to proper judicial administration in the federal system." Under the principle articulated in *La Buy,* the writ of mandamus has served to afford review of extraordinary interlocutory orders. Thus, the issuance of this writ was directed in *Beacon Theatres* v. *Westover,* 359 U. S.

500 (1959), to vacate an order directing trial of certain issues to the court rather than to a jury, and in *Schlagenhauf* v. *Holder,* 379 U. S. 104 (1964), to vacate an order for medical examination of a defendant. The writ of mandamus is available to vacate orders denying *forum non conveniens* motions under § 1404(a)—*Chicago, Rock Island and Pacific Railroad Co.* v. *Igoe,* 220 F. 2d 299 (7 Cir. 1955), cert. denied 350 U. S. 822 (1955); *General Tire & Rubber Company* v. *Watkins* (*supra,* p. 20), and to review the grant or refusal of a stay—*Pet Milk Company* v. *Ritter,* 323 F. 2d 586, 588 (10 Cir. 1963).

The petition cites (P. 22-3) *Bankers Life & Cas. Co.* v. *Holland,* 346 U. S. 379 (1953), as authority for the proposition that the writ of mandamus was not available in this case. In *Bankers Life,* this Court authorized use of the writ of mandamus where "there is a clear abuse of discretion" (346 U. S. at 383), the very reason why the Court below issued the writ.

CONCLUSION

The petition should be denied.

Respectfully submitted,

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January 30, 1968

APPENDIX A

District Court Opinion

Delivered From The Bench September 15, 1965

Suttle, District Judge

The Court: Well, the thing that puzzles me more than anything else as a practical matter is that we have a plaintiff here who testifies that he doesn't have the funds to litigate and I can't think of anything more fair than for him to have the privilege of litigating his law suit in his own backyard and calling on his friends and former employees to testify for him, without any expense. (R. 447)

* * *

The Court does place himself in the position of the Plaintiff and looks at it from the Plaintiff's side just as he has looked at it from the Defendant's side, and considering all the factors in evidence here, the convenience of the parties, and the witnesses, and the interest of justice, it seems to me that this Court couldn't do a greater service to the parties concerned, especially the Plaintiff, than to try his case in his own back yard, that is always the ultimate objective of nearly every litigant, to try it in a friendly atmosphere, and the Court has considered all possibilities of what the Court could do under the law, as he interprets it, and I have come to the conclusion that the injunction that this Court issued in this case No. 2657 on September 2, 1964 should be vacated as to the proceedings in the Kansas case, No. W-3222, "*ACF Industries, Inc.* vs. *Victor Hecht* and *The Hecht Valve Company, Inc.*", and that the proceedings in this case should be stayed pending the determination of the liability issue, the validity of the patent, in other words, or the issues in that Kansas case, and the Court will ask

the counsel for the defendants in this case to prepare an appropriate order setting forth that action by the Court. It does not appear to the Court that it is necessary at this time to make a ruling on the venue motions as such or order a dismissal or transfer, either one, and I believe the interests of justice will best be served by determining the Kansas case first, even though it was filed twelve days after this one was filed. (R. 452-3)

APPENDIX B

DISTRICT COURT ORDER
Entered December 16, 1966

Guinn, District Judge

ON THE 21st day of November, 1966 came on to be heard Plaintiff's Motion to Set Aside Stay Order, to Overrule Motion Filed by Defendants for Change of Venue, to Dismiss Motion Filed by Defendants for Forum Non Conveniens, and to Grant Temporary Restraining Order Restraining Defendants from Proceeding with Causes now Pending in United States District Court of Kansas;

And came the parties by their attorneys and the Court having heard the argument of counsel and considered the evidence offered in support thereof by the parties and considered the briefs of the parties, is of the opinion that the Stay Order heretofor entered in this cause on September 16, 1965 should be set aside;

It is therefore ORDERED, ADJUDGED and DECREED that said Stay Order entered on September 16, 1965 be and hereby is SET ASIDE;

It further appearing to the Court that the Court should pass upon the Defendants' Motions for Change of Venue and Forum Non Conveniens, and the Court having considered evidence submitted in regard thereto, and the argument of counsel, is of the opinion and finds that the Court has venue and further finds Defendant's Forum Non Conveniens Motion should be OVERRULED; and further finds that in the furtherance of convenience the issues of the validity of the Patent involved and the alleged infringement thereof should be tried separate and apart from the issue of damages, and that said issues should be tried in the Western District of Texas which has jurisdiction and venue of said cause of

action, and where suit was first filed and jurisdiction to determine the issues involved first acquired;

It is therefore ORDERED, ADJUDGED and DECREED by the Court that the Defendants' ACF Industries and Chrysler Corporation, Incorporated request for a change of venue be and hereby is DENIED;

And it further appearing to the Court from the evidence heretofore offered in said cause in connection with the above Motion and the statements and argument of counsel that said cause is ready for setting for jury trial on the issues of validity of patent involved and alleged infringement;

It is therefore ORDERED, ADJUDGED and DECREED that said cause be and hereby is set for jury trial at El Paso, Texas on the 1st day of May, 1967, as to the issues of validity of patent involved and alleged infringement.

It is further ORDERED that plaintiff's Petition for Temporary Restraining Order be DENIED. (R. 778-9).